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Opinion of the Court Below.

The opinion of the Circuit Court of Appeals (R. 1019) is officially reported in 122 F. (2d) 182.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1941.

No.

THE MAYTAG COMPANY and MAYTAG SALES CORPORATION,

Petitioners,

vs.

THE APEX ELECTRICAL MANUFACTURING COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable Harlan F. Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States.

Your petitioners respectfully show:

I.

Summary Statement of Matter Involved.

Petitioners (defendants below) seek a review of a judgment of the Seventh Circuit Court of Appeals entered (R. 1033) June 17, 1941 (petition for rehearing denied September 11, 1941, R. 1049). That judgment affirmed a judgment of the District Court of the United States for the Southern District of Indiana (Indianapolis Division), adjudging claims 3, 5, 8, 9, 10 and 11 of the expired Eden patent No. 1,408,869 (R. 814), issued March 7, 1922 (application filed in August, 1917), on so-called improvements in a wringer for washing machines, valid and infringed by the swinging wringers of The Maytag Company's washing machines, Models 10 and 110 (P. E. A., B), and directing an accounting of profits and damages (R. 764-5). No injunctive relief was granted as the patent had expired more than a year before the judgment of the District Court was entered.

Respondent did not acquire the Eden patent until April, 1934 (R. 761), about seven years after the accused machines were put on the market, more than twelve years after it was issued, and nearly seventeen years after the filing of the application upon which it was granted. Respondent did not purchase the Eden patent until some ten months after it had acquired one of the accused machines (P. E. A.).

While respondent gave notice of infringement within a few months after it acquired the Eden patent and shortly thereafter asserted it in a counterclaim against The Maytag Company in a then pending suit brought by the latter on a "swinger wringer" license, upon dismissal of the suit following a settlement of the controversy over the license, respondent on February 14, 1935 dismissed its

counterclaim without prejudice and thereafter made no further representation or claim of infringement of the Eden patent against either of the petitioners until November 25, 1936, a year and ten months later, when it first notified Maytag Sales Corporation of infringement (R. 534). The bill of complaint in this suit was not filed until December 7, 1936, and the Eden patent expired before it was tried. During all that time, from 1927 on, respondent knew of the accused machines and of their extensive sale (R. 104).

The Eden patent* relates solely to an interlocking device added to an old, two-handle wringer control mechanism for preventing operation of the wringer while it is being swung from one position to another by the operator. This device involves merely the specific positioning of a common spring-pressed pin between an old, peripherally flanged, grooved clutch for controlling the operation of the wringer rolls, and the handle of a previously well-known form of latch for locking the wringer in positions of adjustment.

Although respondent's predecessors in title were engaged in making and selling washing machines equipped with swinging wringers and were licensed by The Maytag Company and marked their machines under its "swinging wringer patents" (R. 571, 588, D. E. 67, 69), the record fails to show that the interconnecting or interlocking mechanism of the Eden patent was ever made, sold or used, or that any machine was ever marked under that patent prior to the time when respondent acquired it (R. 132).

The accused Maytag construction* was introduced in September, 1927 as a part of a newly designed wringer control mechanism, one of the features of which was a single handle control of the wringer (R. 232, 225). It has no grooved, peripherally flanged slidable clutch or any

* See diagrammatic sketch in Appendix.

of the other essential Eden features or any equivalent thereof.

It is only by interpreting the word "means" and other functional statements of the asserted Eden claims broadly enough to cover any kind of mechanism for preventing "adjustment of the wringer while it is under operation of the power drive" that any of them can be read on the Maytag wringers charged to infringe.

Notwithstanding respondent's predecessors in title knew of the extensive manufacture and sale of the accused devices from 1927 on during a period of nearly seven years (longer than the statutory limitation on the bringing of actions for infringement, U. S. C. Tit. 35, Sec. 70) and were in close relationship with The Maytag Company (R. 126-9, 221-6), they gave no notice and made no claim that the Eden patent was being infringed (R. 130-1, 135, 126, 221-6).

Prior to the decisions below, the Eden patent had been held valid and infringed by the District Court for Connecticut (Judge Thomas) in *Apex Co.* v. *Landers, Frary & Clark,* 21 F. Supp. 241, but an appeal and decision by the Second Circuit Court of Appeals as to that patent were averted by the acceptance in settlement of the suit as to it of the nominal sum of $1500 (R. 110, 430). Overlooking substantial differences in the issues and proof in the two cases, the decision in the *Landers* case was much relied on by respondent and the lower courts in the instant case.

It is unlikely, in view of the fact that the Eden patent has expired, that there will be any other litigation out of which a conflict of decisions with respect to it between different Circuit Courts of Appeals might arise.

In both the Court of Appeals and the District Court, the contested issues included:

(1) Whether respondent is barred from any recovery of profits or damages (or other relief) under

the expired Eden patent because of the laches of its predecessors in title in failing to give any notice of or otherwise assert a claim of infringement of that patent against defendants' swinging wringer involved in this suit for a period of seven years (1927 to 1934), knowing during all that time that this structure was being extensively advertised, sold and used throughout the United States, and because of its own lack of diligence in pressing its claim (R. 86, 761, 771).

(2) Whether the asserted claims of the Eden patent are each invalid:

. . . Because the only feature of each of these claims which affords any basis for even a pretense of novelty, *i.e.*, positioning an interlocking or interconnecting means between two old and well known movable parts of a swinging wringer (a mere matter of ordinary mechanical skill), is stated in functional language; . . . (R. 765-9).

(3) Whether the asserted claims, containing a functional statement at the sole point of novelty, can be so interpreted as to cover a device radically different from that shown in the drawings and described in the specification simply because the functional language embraces a common result (R. 66, 71, 765, 767, 769, 770).

The Court of Appeals failed to appreciate that a question of law only was involved and declined to review the finding of the trial court (R. 761) that respondent was not barred by laches from maintaining its action because it and its predecessors in title to the Eden patent in suit had no knowledge that the petitioners were infringing this patent until after the purchase of it by respondent, saying (R. 1025):

"These were all questions of fact and were sharply

> contested. There was substantial evidence in support of the lower court's finding and we cannot disturb it."

Contrary to the statement of the Court, petitioners submit that there was no substantial evidence to support the lower court's finding on the issue of laches, and no question of credibility of witnesses involved; therefore, FRCP 52 (a) does not apply.

The only evidence supporting the adverse finding of the trial court on the issue of laches is a statement of the witness Hess, the president of an antecedent owner of the Eden patent, whose job it was to have taken care of any infringement. He testified, in answer to a leading question put by counsel for respondent, that he did not know that "the Eden patent was *being infringed* by The Maytag Company" (R. 123-124), obviously a mere conclusion of law. But other testimony of the same witness very clearly shows that he *did know* that the accused machine was being extensively advertised, sold and used and was easily accessible to him from 1927 on during a period of seven years, and that in the circumstances he was under an obligation to ascertain whether the Eden patent was *being infringed* and, if it was, to assert a claim of infringement against The Maytag Company (R. 130-1, 135; 222-3, 225, 236-8, 600; D. E. 73). Thus the issue of laches became a question of law solely, unaffected by FRCP 52 (a), which it was the duty of the Court of Appeals itself to determine independently of the finding and conclusion of the District Court.

The District Court (R. 760) sustained the validity of the claims of the Eden patent in suit without specifically ruling upon the question of functionality embraced in the second contested issue. But the Court of Appeals (R. 1022) considered this question and determined it adversely to petitioners on the previous rulings of that court in *Gil-*

christ Co. v. *Kar-Lac Co.*, 29 F. (2d) 153, and *Research and Development Corporation* v. *Chase*, 88 F. (2d) 353. These it regarded as based on *Continental Paper Bag Co.* v. *Eastern Co.*, 210 U. S. 405, decided in 1908. This was done without discussion or apparent consideration of the decision of this Court thirty years later (1938) in *General Electric Co.* v. *Wabash Co.*, 304 U. S. 364, 371, inhibiting the employment in a patent claim of functional language at the exact point of novelty, which was called to the attention of the Court of Appeals, and petitioners submit, should have controlled the determination of this issue on the record.

With respect to the third contested issue, that of infringement, the Court of Appeals instead of independently determining that question of law felt itself obliged to adhere to the finding of the trial court that the accused construction was the equivalent of the device of the Eden patent, saying in part (R. 1025):

> "There was certainly substantial evidence to support this conclusion, and though we might not agree with the trial court, yet we are not privileged to disturb its conclusion in this respect, for findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses, Rule 52 of the Federal Rules of Civil Procedure; *General Motors* v. *Swan Co.*, 44 F. (2d) 24; *Stevens* v. *Schmid, Inc.*, 73 F. (2d) 54."

The Court of Appeals also declined to apply the ruling of this Court in *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 208, saying (R. 1025):

> "It is argued by appellants that in *Miller* v. *Eagle Co.*, 151 U. S. 186, it was held that interchangeability is a test of infringement, but under the facts there present we think it is clear the Court referred to functional rather than physical interchangeability. This would seem to be true in the light of more recent

decisions. *Continental Co.* v. *Eastern Co., supra; Hildreth* v. *Mastoras,* 257 U. S. 27; *Eibel Co.* v. *Paper Co., supra;* and *Sanitary Co.* v. *Winters* 280 U. S. 30."

In so holding the Court of Appeals departed from the decision of this Court in *Singer Manufacturing Co.* v. *Cramer,* 192 U. S. 265, 275, to the effect that the rule which is incorporated in FRCP 52 (a) is not applicable where the question of infringement is one of law determinable from mere comparison of the respective structures, as in this case, and sanctioned a test of infringement contrary to that of *Miller* v. *Eagle Mfg. Co.,* 151 U. S. 186, 208, namely, interchangeability of the specific devices in question, or as applied in *Westinghouse* v. *Boyden Co.,* 170 U. S. 537, 570, substantial identity of means as distinguished from mere identity of function or result.

Questions Involved.

1. Whether in an action for equitable relief, upon proper assignment of error, FRCP Rule 52 authorizes a Circuit Court of Appeals to refuse its independent determination of—

   (a) an issue of laches, where the District Court's finding on that question depends solely upon the legal effect of testimony, no question of credibility being involved?

   (b) an issue of patent infringement, a question of law determinable from mere comparison of structures and not depending upon the credibility of any witness?

2. Whether the claims of the Eden patent in suit are invalid under *General Electric Co.* v. *Wabash Co.,* 304 U. S. 364, 371, inhibiting the employment in a patent claim of functional language at the exact point of novelty?

3. Whether a federal court of equity may lend its aid to the enrichment of a late, speculative purchaser of a patent for an invention lacking in commercial background and which expired before trial, in an action for infringement, where it appears that its predecessor in title gave no notice and made no claim of infringement, although it knew of the extensive advertising, manufacture and sale of the accused devices for a period exceeding the statutory period of limitation, and plaintiff was not diligent in asserting and prosecuting a claim of infringement?

4. Whether the asserted claims of the patent in suit are infringed by the accused devices under *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 208, and other cases limiting the scope of claims of such functional character to the specific devices shown in the drawings and described in the specification of the patent?

II.

Reasons for Granting the Writ.

1. In refusing its independent determination of the issues of laches and infringement in this case, which on the record are issues of law, not of fact, upon the supposed authority of FRCP 52 (a), the Court of Appeals has in effect denied petitioners a review of important questions of law properly presented by the record on appeal and thereby so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

2. The Court of Appeals departed from *Singer Manufacturing Co.* v. *Cramer*, 192 U. S. 265, 275, in invoking FRCP Rule 52 (a) against independent determination by it of the issue of infringement, the question being one of law determinable from mere comparison of the respective

structures and not depending upon the credibility of any witness.

3. The decision of the Court of Appeals sanctions a test of patent infringement in conflict with *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 208, *Westinghouse* v. *Boyden Co.*, 170 U. S. 537, 570, and other decisions of this Court.

4. The opinion of the Court of Appeals in relying upon *Continental Paper Bag Co.* v. *Eastern Co.*, 210 U. S. 405, and its own previous rulings based thereon, as supporting its decision upholding the validity of the claims of the Eden patent in suit notwithstanding the repeated contentions of petitioners that they are invalid under *General Electric Co.* v. *Wabash Co.*, 304 U. S. 364, 371, inhibiting the employment in a patent claim of functional language at the exact point of novelty, indicates misapprehension or confusion with respect to this important rule of law and decisions of this Court pertaining thereto which should be clarified by this Court.

5. The Eden patent in suit has expired and the only other suit upon it was settled for a nominal sum before appeal. It is unlikely therefore, that any conflict of decision among Circuit Courts of Appeals affecting the issues in this case will arise. Unless this Court grants the writ now sought, the decision in the instant case will not only become a precedent in conflict with applicable decisions of this Court upon important questions of federal procedure, of laches, and of the substantive law of patents, but will result in great inequity to petitioners.

6. In affirming the judgment of the trial court and thus lending its aid to the enrichment of a late, speculative purchaser of a patent for an invention lacking in commercial background, and which expired before trial, where it appeared that its predecessors in title had given no notice and made no claim of infringement although know-

ing of the defendants' extensive advertising, manufacture and sale of the accused devices for a period of nearly seven years and exceeding the statutory period of limitation, the Court of Appeals has determined an important question of federal law in conflict with applicable decisions of this Court and other Circuit Courts of Appeals.

Wherefore, petitioners pray that a writ of certiorari issue under the seal of this Court directed to the United States Circuit Court of Appeals for the Seventh Circuit, sitting at Chicago, Illinois, commanding said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings of the said Circuit Court of Appeals had in the case numbered and entitled on its docket No. 7394, *The Apex Electrical Manufacturing Company, Plaintiff-Appellee,* v. *The Maytag Company and Maytag Sales Corportaion, Defendants-Appellants,* to the end that this cause may be reviewed and determined by this Court; that the judgment therein of the Circuit Court of Appeals be reversed by this Court, and the cause remanded to that Court with directions to reverse the judgment of the District Court and for such other and further relief as this Court may deem proper.

WALLACE R. LANE,
BENTON BAKER,
Counsel for Petitioners.

BRIEF IN SUPPORT OF PETITION.

Jurisdiction.

Petitioners would invoke the jurisdiction of this Court under Section 240 (a) of the Judicial Code as amended by Act of February 13, 1925, U. S. C. Tit. 28, Sec. 347, to review a judgment of the Seventh Circuit Court of Appeals entered June 17, 1941 (R. 1033), in a suit for patent infringement brought under U. S. C., Tit. 28, Sec. 109; a petition for rehearing was denied September 11, 1941 (R. 1049). The petition is presented within three months from and after the denial of petition for rehearing.

Statement.

The petition contains a sufficient summary of the material facts for an understanding of the reasons relied upon for the allowance of the writ and statement of the questions involved.

Specification of Errors.

The Circuit Court of Appeals erred:

(1) In refusing its independent determination of the issues of laches and infringement and adopting the findings of fact of the District Court.

(2) In not adjudging that respondent is barred from any recovery of profits or damages because of the laches of its predecessors in title, and because of its own lack of diligence in pressing its claim.

(3) In failing to adjudge claims 3, 5, 8, 9, 10 and 11 of Eden patent No. 1,408,869, invalid and not infringed, and in not reversing the judgment of the District Court and ordering that the bill of complaint be dismissed with costs.

(4) In affirming the judgment of the District Court holding said claims valid and infringed and ordering an accounting of profits and damages.

ARGUMENT.

I.

In Refusing its Independent Determination of the Issues of Laches and Infringement and Thus Depriving Petitioner of a Review of Important Questions of Law the Court of Appeals has Applied FRCP 52 (a) in a Manner Manifestly Contrary to Its Provisions and Calling for the Exercise of the Supervisory Power of this Court.

FRCP 52 (a) by its express terms very clearly indicates that it was not intended to limit the right of a litigant to a review of questions of law properly presented on the record on appeal under U. S. C., Tit. 28, Sec. 225. The barrier of that rule applies only to *findings of fact* which are not clearly erroneous.

In the instant case, with respect to the issues of both laches and infringement, there was no dispute as to the facts, no question of the credibility of witnesses, but a question of law as to whether or not on the undisputed facts the essential elements of laches and infringement were present.

As to laches, the finding of the District Court (R. 761) that respondent and its predecessors in title had no knowledge that petitioners "were infringing" the Eden patent until after respondent purchased it was beside the point. The question before the court was whether or not in the circumstances the respondent and its predecessors were charged with the duty of giving notice or making a claim of infringement against The Maytag Company. This question does not depend on whether or not they knew that petitioners "were infringing" the Eden patent.

As this Court more than once has said, "the law im-

putes knowledge when opportunity and interest, combined with reasonable care, would necessarily impart it.

"Not to improve such opportunity, under the stimulus of self-interest, with reasonable diligence, constitutes laches which in equity disables the party, who seeks to revive a right which he has allowed to lie unclaimed, from enforcing it to the detriment of those who have, in consequence, been led to act as though it were abandoned." *Wollensak* v. *Reiher,* 115 U. S. 96, 99; *Ives* v. *Sargent,* 119 U. S. 652, 661; *Booth Fisheries Corp.* v. *Coe,* 114 F. (2) 462, 463 (App. D. C.).

The record in the instant case clearly calls for the application of the rule thus stated. In addition to differences of construction between the accused device and that of the Eden patent, indicating non-infringement, the record incontrovertibly shows:

(1) That throughout the entire period under consideration, that is, from 1927 on, respondent and its predecessors in title were in close relationship with The Maytag Company by virtue of their being licensees of that company under patents relating to swinging wringers of the type shown in the Eden patent, and exchanged circulars illustrating their respective machines, including those involved in this case (R. 130-1, 135, 222-3, 225, 236-8, 600; D. E. 73, R. 598).

(2) That during such entire period respondent and its predecessors in title knew of the extensive advertising, manufacture, and sale throughout the country by The Maytag Company of washing machines equipped with the accused devices (R. 104, 130-1, 135).

(3) That the single handle control is a conspicuous feature of those machines and was emphasized in the circulars referred to (D. E. 73, R. 598) and although

the interlocking mechanism, as that of the Eden patent, is enclosed within a housing, anyone at all interested must, upon trying to operate its distinctive single handle control, immediately be impressed with the interconnection or interlock preventing swinging of the wringer while the wringer rolls are in operation, and easy access to the interior is afforded upon the simple removal of two screws.

(4) That no notice was ever given and no claim ever made of infringement of the Eden patent, and no machine or device was ever marked under it, although respondent and its predecessors were making swinging wringers, during that time (R. 24-6, 129-30).

(5) That in the period under consideration The Maytag Company sold more than a million machines equipped with the accused device, which went into use in homes throughout the country, and went to great expense unaware that it was years later to be confronted with a charge of infringement of the Eden patent (R. 241-2, 226).

In this state of facts the question of laches becomes one of law controlled by the rule of *Wollensak* v. *Reiher* and *Ives* v. *Sargent* above-quoted and it is immaterial that respondent and its predecessors in title had no knowledge that petitioners "were infringing" the Eden patent.

As to infringement, this Court in *Singer* v. *Cramer,* 192 U. S. 265, 275, laid down the rule that it is a question of law where the Court is able, as in this case, "from mere comparison to comprehend what are the" respective structures "and from such comparison to determine whether or not" the one "is an infringement upon" the other. It was the duty of the Court of Appeals to have followed this rule and determined the issue of infringement itself by comparison of the accused device with that of the Eden

patent instead of holding itself obligated to accept the findings and conclusion of the District Court on this issue under FRCP 52 (a).

The issues of laches and infringement on the record were issues of law determinative of the action. A decision for petitioners on either issue would have required a reversal of the judgment of the District Court. The Court of Appeals' refusal of its independent consideration and determination of these issues deprived petitioners of a substantial right and established a precedent contrary to the public interest, and should be corrected through the issuance of the writ of certiorari.

That in the circumstances presented a writ of certiorari will issue, see *Chandler Co.* v. *Brandtjen, Inc.*, 295 U. S. 724; 296 U. S. 53; *Sibbach* v. *Wilson & Co.*, 309 U. S. 650; 312 U. S. 1.

II.

The Decision of the Court of Appeals Indicates Confusion Regarding the Application of the Test of Infringement Prescribed in Miller v. Eagle Mfg. Co., 151 U. S. 186, 208, and Westinghouse v. Boyden Co., 170, U. S. 537, 570, Which this Court Should Correct.

Relying on *Continental Co.* v. *Eastern Co.*, 210 U. S. 405, *Hildreth* v. *Mastoras*, 257 U. S. 27, *Eibel Co.* v. *Paper Co.*, 261 U. S. 45, and *Sanitary Co.* v. *Winters*, 280 U. S. 30, the Court of Appeals declined to apply the test of *physical* interchangeability as indicated in the *Miller* case thinking that this Court intended the test to be that of *functional* interchangeability (R. 1025). The error of the Court of Appeals is indicated by its own opinion in the earlier decided case of *Jogger Manufacturing Corp.* v. *Roquemore*, 118 F. (2), 867, now pending in this Court on

petition for writ of certiorari (No. 1064), where the Court speaking through Judge Evans said (p. 870):

> "Plaintiff's counsel has rather adroitly interchanged the functions and the elements of the accused device, thereby creating some confusion as to their equivalency. Functions may well be investigated and examined to ascertain the range of mechanical equivalents. But *there is no basis for asserting infringement because of similarity of functions. There must be similarity of elements which perform the desired functions before infringement is shown.*"*

Other inconsistent decisions of the same court include *Benoit* v. *Wadley*, 54 F. (2) 1041, 1043; *Hajek* v. *Radio Corp.*, 83 F. (2d) 1, 2; *Burroughs Adding Machine Co.* v. *Felt & Tarrant Mfg. Co.*, 243 Fed. 861, 868-9. See also *American Laundry Machine Co.* v. *Strike*, 103 F. (2d) 453, 457, C. C. A. 10. In all those cases the court correctly applied the rule limiting the claims of the patent sued upon to the elements shown in the drawings and described in the specification just as though each of them was specifically enumerated in the claims. And that is what should have been done in the instant case.

Moreover, the decisions of this Court relied on by the Court of Appeals do not go so far as that court seemed to think. In the *Paper Bag Patent* case (210 U. S. 405) the problem was that of bringing two parts into a working relation. That had never been done. The Court pointed out that there were two ways of doing it saying (p. 421):

> "The problem may be solved by causing the pivot or axis of the folding plate to yield away from the cylinder, or by causing the surface of the cylinder to be depressed away from the folding plate. The patent in suit adopts the first device, the defendant's machine the second, and the crucial question before the court is this; Under all the circumstances of the

* Emphasis ours.

> case, is the second method, as compared with the first, within the doctrine of equivalents?"

And the question was answered in the affirmative.

In the instant case Eden merely positioned a specific, old form of interlock in a new location. Petitioners, on the other hand, reconstructed the entire control mechanism and used a different form of interlock, operating in an entirely different way, in a different location to achieve the same result. In such a case the doctrine of the *Paper Bag Patent* case would not apply.

In *Hildreth* v. *Mastoras*, 257 U. S. 27, the patent sued upon also was a pioneer, entitled to a broad range of equivalents and the accused machines operated upon the same principle as the machine of the patent and the doctrine of equivalents was held to be applicable. In *Eibel Co.* v. *Paper Co.*, 261 U. S. 45, the elements of the defendant's machine were plain mechanical equivalents of the elements of the patented machine. In *Sanitary Co.* v. *Winters*, 280 U. S. 30, there was a mere colorable departure from the description in the patent. Obviously the cases cited do not support the ruling of the Court of Appeals.

In *Westinghouse* v. *Boyden Co.*, 170 U. S. 537, 570, in which a similar argument was advanced in behalf of plaintiff, this Court after pointing out that infringement involves substantial identity of means employed as well as of result, said (p. 568):

> "The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term equivalent."

The radical departure of the holding of the Court of Appeals on the subject of interchangeability as a test of infringement from the rule of *Miller* v. *Eagle Mfg. Co.*,

and *Westinghouse* v. *Boyden Co.,* calls for the issuance of the writ.

III.

The Reliance of the Court of Appeals on the Paper Bag Patent Case in Upholding the Validity of Claims of the Eden Patent Which are clearly Within General Electric Co. v. Wabash Co., 304 U. S. 364, 371, Inhibiting the Employment in a Patent Claim of Functional Language at the Exact Point of Novelty, Calls for Clarification by this Court of the Law on the Point.

In *General Electric Co.* v. *Wabash Co.*, 304 U. S. 364, the Court disapproved partially functional claims saying (p. 371):

> ". . . the vice of a functional claim exists not only when a claim is 'wholly' functional, if that is ever true, but also when the inventor is painstaking when he recites what has already been seen, and then uses *conveniently functional language at the exact point of novelty.*"*

That is precisely what was done in the Eden patent in suit. Claim 8, which the Court of Appeals selected as typical of the claims of the Eden patent in suit reads:

> "In a device of the character described, the combination with a wringer pivoted about a vertical axis, and a driving member concentric with said axis, for operating the same, of means for making and breaking the operative connection between said member and wringer, means for locking said wringer in fixed position relatively to said vertical axis, and *means preventing the making of operative connections between said member and wringer except when said wringer is locked.*"

This claim depends for novelty,—if it has any in view of

---

* Emphasis ours.

the fact that everything else was admittedly old and shown in the prior art of record (R. 844-953, 978), on the italicized portion, which is a purely functional phrase in terms embracing any means for preventing the making of an operative connection between the driving member and the wringer except when the wringer is locked so that it cannot be swung about its vertical axis. The other claims in suit have similar functional phrases.* Certainly these functional statements come within the inhibition of the *General Electric* case.

The subject of functional claims is an important one in the law of patents and the line of demarcation between proper and improper functional statements in patent claims ought to be clearly defined.

IV.

The Decision of the Court of Appeals Conflicts with Applicable Decisions of this Court and Other Circuit Courts of Appeals on the Subject of Laches and Adds to the Already Existing Confusion Among the Federal Courts as to the Law on that Subject.

In affirming the judgment of the District Court the Court of Appeals not only adopted the finding of the trial court on the issue of laches but approved that portion of the judgment awarding respondent an accounting of profits and damages, which is based on a conclusion of law as follows (R. 761):

> "Plaintiff is not barred by laches from maintaining its action and is entitled to an accounting of profits and damages for the infringement of the Eden patent during the period plaintiff has owned this patent. The question is reserved for ruling in the accounting as to whether plaintiff is entitled to any accounting for any previous period."

---

* We have attached in an appendix a copy of the Eden patent with underscoring indicating in claims 3, 5, 8, 9, 10 and 11 the functional language used at the sole point of novelty.

The incongruity thus presented springs from the confused state of the law on the subject of laches resulting from *Menendez* v. *Holt*, 128 U. S. 514, 524; *Keyes* v. *Eureka Mining Co.*, 158 U. S. 150, 153, 154, and cases there cited, and other decisions of this Court including *Willard* v. *Wood*, 164 U. S. 502, 525; *Electric Co.* v. *Boston Co.*, 139 U. S. 481; *Hartshorn* v. *Saginaw Barrell Co.*, 119 U. S. 664.

On the one hand in numerous decisions of the various circuit courts of appeals denying any recovery of profits and damages, it has been held that it is of no avail that the present owner of a patent may have acted promptly upon acquring title to it as the laches of his predecessors in title is imputed to him. *George J. Meyer Mfg. Co.* v. *Miller Mfg. Co.*, (C. C. A. 7), 24 F. (2d) 505, 506; *A. R. Mosler & Co.* v. *Lurie*, (C. C. A. 2), 209 Fed. 364, 370; *Gillons* v. *Shell Co.*, (C. C. A. 9), 86 F. (2d) 600, 605. *Woodmanse & Hewitt Co.* v. *Williams*, (C. C. A. 6), 68 Fed. 489, 492. See also *Otis Elevator Co.* v. *Atlantic Elevator Co.* 47 F. (2d) 545, 548, C. C. A. 2; *Radio Co.* v. *Coe*, 75 F. (2d) 523 (app. D. C.); *Supreme Mfg. Corp.* v. *Security Mfg. Co.*, 299 Fed. 65, 68, C. C. A. 9.

The Seventh Circuit Court of Appeals, however, notwithstanding its recognition of that rule in the *George J. Meyer Mfg. Co.* case, has done as the District Court in this case has indicated that it might do, that is, allow the present owner a recovery of damages and profits for the period subsequent to his acquisition of title. *Wolf* v. *United States Co.*, 261 Fed. 195, 197; *Imperial Brass Co.* v. *Hackney*, 75 F. (2d) 689, 690, C. C. A. 7. A conspicuous vice of such a rule is that it sanctions the absolution of laches by transfer and gives a speculative purchaser of a patent a right of action which his assignor could not maintain. It thus invites the transfer and litigation of stale claims contrary to public policy.

Manifestly there is an incompatibility between the two views and this Court should resolve the difference.

The principle is well stated in *Speidel* v. *Henrici,* 120 U. S. 377, 387, where the Court, speaking through Mr. Justice Gray, said:

> "Independently of any statute of limitation, courts of equity uniformly decline to assist a person who has slept upon his rights and shows no excuse for his laches in asserting them. 'A court of equity,' said Lord Camden 'has always refused its aid to stale demands, where the party slept upon his rights, and acquiesced for a great length of time. Nothing can call forth this court into activity but conscience, good faith and reasonable diligence; where these are wanting, the court is passive and does nothing. Laches and neglect are always discountenanced; and, therefore, from the begining of this jurisdiction there was always a limitation to suits in this court.' "

In *Hayward* v. *National Bank,* 96 U. S. 611, not a patent case, the delay was only four years. The Court said, however (p. 617):

> "Courts of equity often treat a lapse of time less than that prescribed by the Statute of Limitations, as a presumptive bar, on the ground 'of discouraging stale claims, or gross laches, or unexplained acquiescence in the assertion of an adverse right.' "

The matter is one of principle. In *Westco-Chippewa Pump Co.* v. *Delaware, etc., Co.,* (C. C. A. 3), 64 F. (2d) 185, observing that (p. 187) "a uniform principle runs through all the cases," the Court further said:

> "They proceed on the theory that the plaintiff knows his rights and has had ample opportunity to establish them in the proper forum; that, because of delay, the defendant has good reason to think that the plaintiff believes his asserted rights to be worthless or that he has abandoned them. *Galliher* v. *Caldwell,* 145 U. S. 368, 372, 12 S. Ct. 873, 36 L. Ed. 738."

In the instant case, as the court said in *Delaney Patents Corp.* v. *Johns-Manville* (S. D. Cal.), 29 F. Supp. 431, 436:

> "Laches is clearly present here, as we have an inexcusable delay, in the face of wide commercial use of a product on a national scale by one who, from the circumstances narrated, cannot be said to have drawn upon the patent in suit for his device."

In such a case there is no substantial basis for a compromise or split. It is as inequitable to allow recovery for the period subsequent to respondent's purchase of the Eden patent as for the period prior thereto. This is especially so in view of respondent's own lack of diligence and vacillation in prosecuting its claim resulting in the lapse of more than five years from its acquisition of the patent before the case was brought to trial.

V.

Unlikelihood of a Conflict of Decisions Among Circuit Courts of Appeals Due to Expiration of the Eden Patent, and the Importance of the Questions of Law Involved Call for the Exercise of the Jurisdiction of This Court.

The situation in the instant case is analogous to that in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47. In that case the court recognized that in view of the concentration of the automobile industry in the Sixth Circuit litigation over the patents in suit elsewhere would be unlikely and granted the writ notwithstanding want of conflict between decisions of two circuit courts of appeals. Here the Eden patent has expired and the only other litigation involving it (in which the issues and proof were substantially different) was settled for a nominal sum thus averting a decision of the Second Circuit Court of Appeals with respect to its validity.

The questions of which review is sought are important. The case is, therefore, a proper one for the issuance of the writ.

Respectfully submitted,

WALLACE R. LANE,

BENTON BAKER,

Counsel for Petitioner.

Violation of Rule of this Court in General Electric Co. v. Wabash Co., 304 U. S. 364, 371, Against Use of Functional Language at Exact Point of Novelty Exemplified in Asserted Claims of Eden Patent.

The Eden patent shows a complete washing machine with a swinging wringer attached. The washing machine and wringer constructions are admittedly old.

The only feature on which there can be any pretense of novelty in any of the claims asserted resides in an interlock between the clutch which controls the operation of the wringer rolls and the locking latch which prevents the wringer from swinging while the wringer rolls are being driven.

The specific interlock resides in a spring pressed pin between the handle of the locking latch and a grooved clutch which is mounted between the gears for driving the wringer rolls in either direction, in such a way that the wringer cannot be swung while the wringer rolls are operating.

The interlock is described in each of the claims asserted in functional language only. This functional language is underlined in the within copy of the Eden patent. It is only by disregarding the structure shown in the Eden patent that this language can be read on defendant's structure.

H. W. EDEN.

WRINGER FOR WASHING MACHINES.

APPLICATION FILED AUG. 13, 1917.

1,408,869.

Patented Mar. 7, 1922.

3 SHEETS—SHEET 1.

Fig. 1

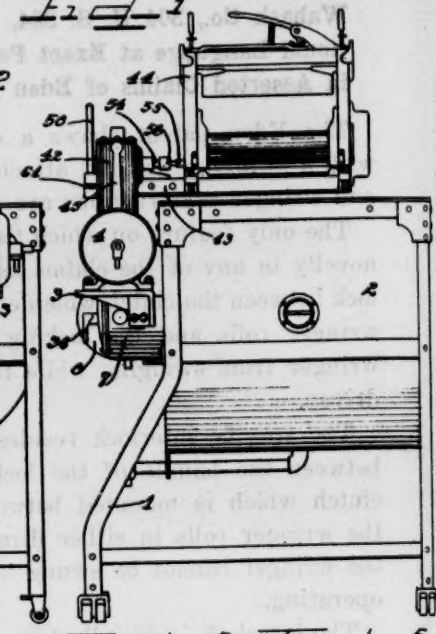

Fig. 2

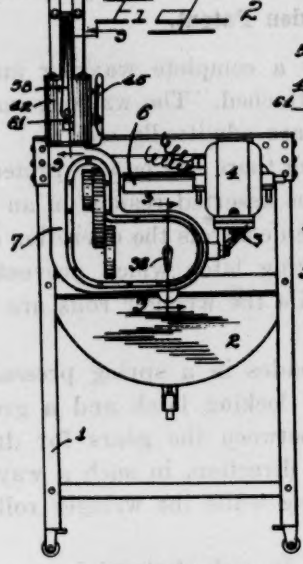

Fig. 3

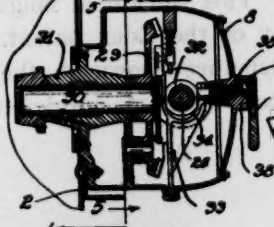

Fig. 4

Fig. 5

Witnesses

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WRINGER FOR WASHING MACHINES.

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1,408,869.

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3 SHEETS—SHEET 2.

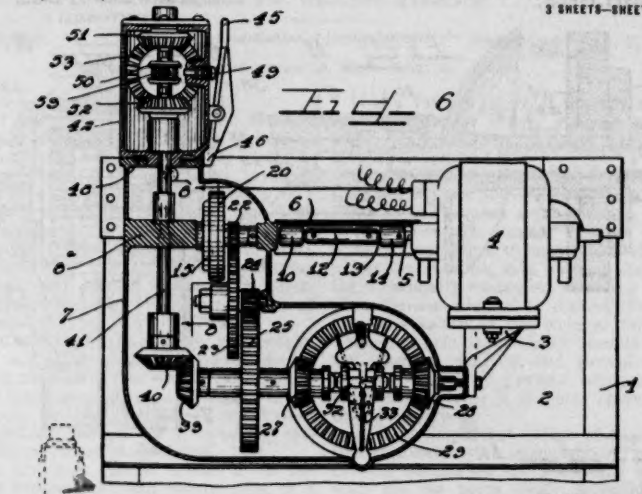

Fig. 6

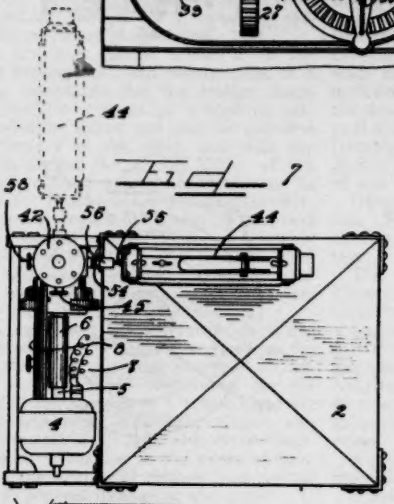

Fig. 7

Fig. 8

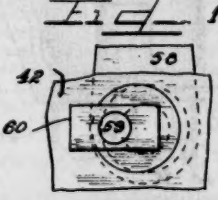

Fig. 10

Witnesses

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WRINGER FOR WASHING MACHINES.

APPLICATION FILED AUG. 13, 1917.

1,408,869.

Patented Mar. 7, 1922.

3 SHEETS—SHEET 3.

Fig. 11

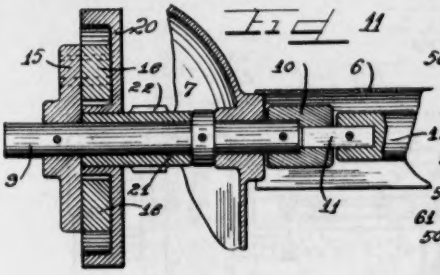


Fig. 9

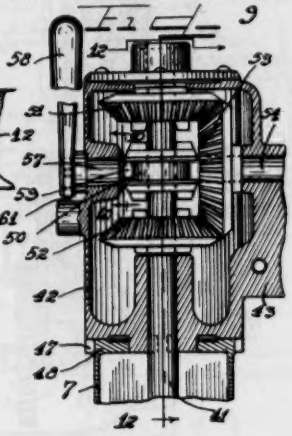


Fig. 12

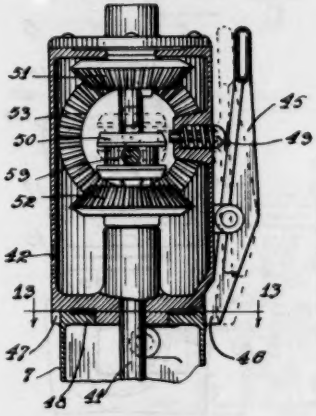
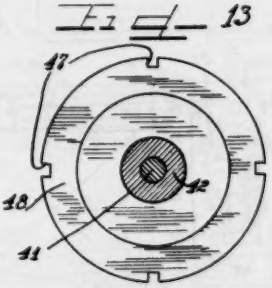


Fig. 13



Witnesses

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UNITED STATES PATENT OFFICE.

HAROLD W. EDEN, OF ALTON, ILLINOIS, ASSIGNOR, BY MESNE ASSIGNMENTS, TO GILLESPIE-EDEN CORPORATION, A CORPORATION OF DELAWARE.

WRINGER FOR WASHING MACHINES.

1,408,869. Specification of Letters Patent. Patented Mar. 7, 1922.

Application filed August 18, 1917. Serial No. 185,895.

To all whom it may concern:

Be it known that I, HAROLD W. EDEN, a citizen of the United States, and a resident of the city of Alton, in the county of Madison and State of Illinois, have invented certain new and useful Improvements in a Wringer for Washing Machines; and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings, and to the numerals of reference marked thereon, which form a part of this specification.

This invention relates more particularly to an adjustably mounted power driven wringer mechanism for use in combination with a washing machine, and is shown and described, but not claimed, in my Patent No. 1,387,696, patent for a "washing machine drive", dated August 16th, 1921.

This invention further relates to an improved arrangement and construction of a driving mechanism for the clothes drum and adjustable wringer of a washing machine whereby either one may be operated independently of the other, and with the drive shaft for the clothes drum of the machine reversed automatically during its operation. Furthermore, a releasable driving means is provided whereby in the event of the clothes drum or the adjustably mounted wringer becoming jammed, said means will permit slippage of the parts until the power can be turned off, thus protecting the mechanism from damage.

It is an object of this invention therefore to construct a driving mechanism for the parts of the washing machine embracing a reversing gear mechanism for the clothes drum, as well as a reversible drive for an adjustably mounted wringer, and with the parts of the reversible drive adapted to cease operation in the event of jamming of the wringer or clothes drum mechanisms to prevent damage to the parts.

It is also an object of this invention to construct a power driven washing machine wherein the driving means for a clothes drum and an adjustably mounted wringer are encased and mounted near the upper end of one side of the machine, and with the driving means for the clothes drum being entirely automatic in operation after the circuit to the driving motor is closed.

It is a further object of this invention to provide a power driven washing machine having a reversible wringer adjustably mounted thereon.

It is furthermore an object of this invention to provide a power driven washing machine having encased driving means mounted upon one side thereof adapted to continuously operate a wringer shaft when the power is turned on, said wringer shaft having a manually controlled reversing mechanism thereon adapted to control the direction of rotation of the wringer rolls of a wringer which is pivotally mounted upon the washing machine and provided with latching means to prevent adjustment of the wringer while it is under operation of the power drive.

It is an important object of this invention to construct an improved and compact driving mechanism for a washing machine with all the parts easily accessible, and mounted upon the upper end of one side of the frame of the washing machine to impart a drive to the clothes drum or an adjustably mounted wringer of the machine alternately or simultaneously independently of one another, as desired.

Other and further important objects of this invention will be apparent from the disclosures in the drawings and specification.

The invention (in a preferred form) is illustrated in the drawings and hereinafter more fully described.

On the drawings:

Figure 1 is a front view of a washing machine showing a wringer mechanism embodying the principles of my invention forming a part thereof and adjustably mounted on one side of the washing machine.

Figure 2 is a side elevation of the washing machine.

Figure 3 is a sectional detail taken on line 3—3, of Figure 2, with parts omitted and parts shown in elevation.

Figure 4 is a sectional detail through one of the gears of the reversing gear mechanism.

Figure 5 is a reduced sectional detail taken on line 5—5, of Figure 3.

Figure 6 is a fragmentary enlarged side view of the washing machine with the cas-

ing of the driving mechanism broken away and shown in section to illustrate the arrangement of the parts.

Figure 7 is a top plan view of the washing machine showing the operation of the wringer in dotted lines.

Figure 8 is an enlarged detail view taken on line 8—8, of Figure 6, with parts omitted and with parts shown in elevation.

Figure 9 is an enlarged fragmentary sectional detail taken on line 9—9, of Figure 2, with parts shown in elevation.

Figure 10 is a detail view of the wringer clutch controlling mechanism, showing a fragmentary portion of the clutch casing looking to the left of the line 10—10 of Figure 9, and shows the clutch shifting block and its support which is mounted in this portion of the casing.

Figure 11 is a fragmentary detail section showing the main drive shaft and friction releasing clutch which are driven by the motor.

Figure 12 is a section taken on line 12—12, of Figure 9, with parts shown in elevation.

Figure 13 is an enlarged section taken on line 13—13, of Figure 12.

As shown in the drawings:

The reference numeral 1, indicates the frame of a washing machine having a tub 2, of any usual or well known construction fitted therein, and with the driving mechanism for the machine mounted on one side of the frame. Mounted upon a bracket 3, which is secured upon the frame of the machine is a driving motor 4, and the drive shaft of said motor, denoted by the reference numeral 5, leads into a tubular casing 6, is connected upon the boss extension of a large base or casing 7, forming a part of or secured upon the frame of the washing machine and provided with an L-shaped cover plate 8, as shown in Figure 3. Said casing 7 is provided with an inwardly projecting extension 8*, as shown in Figure 6, affording a bearing for one end of a shaft 9, and the other end of said shaft extends through the wall of the casing 7 through a bearing provided therefor, and is provided with a coupling 10, pinned thereon. Secured in the coupling 10, is a short shaft section 11, which is pinned to a long coupling shaft or member 12, and pinned in the other end thereof is another short shaft section 13, which is secured in a coupling 14, pinned upon the motor drive shaft 5.

Secured upon the shaft 9, as shown in Figures 8 and 11, is a disk 15, and pivoted thereon are two arms 16, mounted on pintles 17. At the opposite ends of each of said arms 16, from the pintles 17, tension springs 18, are connected between said arms. Said arms are adapted to be thrown outwardly by centrifugal force, thereby thrusting a serrated or roughened clutch surface 19, into contact with the inner periphery of a clutch wheel 20, which is secured upon a sleeve 21, journalled on the shaft 9, the tension springs 18, serving to resist the outward movement of said arms.

Formed integral with the sleeve 21, is a pinion 22. Journalled upon a stud shaft secured in an extension of the frame casing 7, is a large gear 23, meshing with the pinion 22, and rigidly associated with said gear 23, is a small pinion 24. Said pinion 24, meshes with a large gear 25, journalled horizontally in the lower portion of the casing 7. Journalled upon the shaft 26, are a pair of pinions 27 and 28, respectively, each meshing with a large bevel gear 29, which is secured upon a shaft 30, extending through a bearing 31, in the casing 7, into the tub 2, of the washing machine for connection to the clothes drum (not shown) therein. Feathered upon the shaft 26, between the pinions 27 and 28, is a slidable jaw clutch member 32, adapted to engage with either of the complementary jaws provided on the extensions of the pinions 27 and 28, to lock the same to the drive shaft 26, and thereby drive the bevel gear 29. When the jaw clutch member 32, is in the intermediate or neutral position shown in Figure 6, it is out of engagement with both of the pinions 27 and 28, and no drive is imparted to the gear 29, for operation of the clothes drum.

The automatic mechanism for shifting the jaw clutch member 32, first into engagement with the pinion 27, and then into engagement with the pinion 28, to reverse the drive to the clothes drum is the same as that shown in my Patent No. 1,299,925, for "clutch shifting mechanisms," dated April 8th, 1919, and hence the details of construction will not be entered into here since they form no part of the present invention.

The shifting arm or lever for the jaw clutch member 32, is slightly different from that shown in the application above mentioned, and in the present instance, is denoted by the reference numeral 33. Said arm is provided with an extension 34, which fits around the slidable member 32, and the end of the yoke is provided with a recess to receive a spring impelled pin 35, engaged therewith to hold said shifting arm 33, in neutral position. The pin 35, extends into a bearing provided therefor in the cover plate 8, and at its outer end is provided with a handle or crank 36, with a cam projection or extension 37, adapted to coact with an inclined cam portion 38, of the cover plate 8, so that by a rotational adjustment of the handle 36, the portion 37, rides upwardly on the cam portion 38, thereby retracting the pin 35, against the stress of the spring and releasing the arm 33.

Secured upon the outer end of the shaft 26, is a bevel pinion 39, meshing with a bevel

pinion 40, which is secured on the lower end of a shaft 41, extending upwardly within the casing. The shaft 41, extends into an adjustable support or housing 42, pivotally mounted upon the upper end of the casing 7, and supported at one side of the housing upon a frame bracket or arm 43, is a power driven wringer 44. The housing 42, together with the wringer, is limited in its different adjusted positions upon the upper end of the casing 7, by means of a lever 45, pivoted on one side thereof with the lower end 46, of the lever shaped to permit the same to engage in any one of a plurality of notches 47, formed in a top plate 48, of the casing 7, as clearly shown in Figures 12 and 13, to hold said housing 42, and the wringer 44, in different adjusted positions. The lever 45, is normally held in engaging position by a spring impelled detent 49, mounted in the side wall of the adjustable housing. Feathered upon the upper end of the shaft 41, within the housing 42, is a slidable jaw clutch element 50, adapted to interlock with either one of two bevel pinions or gears 51 and 52, respectively, journalled upon said shaft 41, within the housing 42. Each of the bevel pinions 51 and 52, meshes with a bevel gear 53, secured upon a shaft 54, journalled through the side wall of the housing 42, and to which one of the wringer roll shafts 55, is connected by means of a coupling 56.

When the clutch member 50, is in either one of its engaged positions, the periphery thereof is so disposed as to prevent inward movement of the spring detent 49, whereby the lever 45, is held against movement into a release or unlatching position so that it is obvious that no adjustments of the housing 42, can be made while the wringer is under the operation of the power drive.

Journalled through the side wall of the housing 42, is a shaft 57, as shown in Figure 9, provided with an actuating handle 58, on the outer end thereof, and on its inner end provided with an eccentric pin 59, on which is journalled a block 60, for engagement with the central peripheral groove of the slidable clutch member 50. Adjustments of the handle 58, serve to shift said clutch member 50, into engagement with either one of the pinions 51 and 52, or into a neutral position therebetween when the lever 58, is in the upright position shown in Figure 9. A spring detent 61, is provided mounted in an extension of the housing 42, to coact with the lower end of the lever 58, as shown in Figure 9, to hold the same in neutral position.

The operation is as follows:

The drive for the washing machine is received from the motor 4, through the shaft assembly 5—12—9, to the disk wheel 15, and through the centrifugally actuated friction arms 16, to the clutch wheel 20. The pinion 22, rigidly associated with the clutch wheel 20, in turn drives the large gear 23, which, with the pinion 24, rigidly associated therewith, drives the large gear 25, on the shaft 26. The shaft 26, serves to transmit a drive through the reversing gear mechanism to the clothes drum within the tub 2, and also to the upright wringer shaft 41. When the lever 36, is moved into the position shown in Figure 3, the pin 35, engages with the yoke arm 34, of the shifting lever 33, holding the same in neutral position and preventing engagement of the slidable clutch member 32, with either of the pinions 27 and 28, so that no drive is imparted to the clothes drum.

The upright wringer shaft 41, is driven continuously with the shaft 26, and the wringer may be driven at the option of the operator by swinging the clutch lever 58, in one position or the other to drive the wringer in either direction, by throwing the clutch element 50, into engagement with either one of the pinions 51 or 52, disposed within the adjustably mounted housing 42, thus transmitting a rotary motion to the wringer rolls. The direction of rotation of said wringer rolls may be reversed by simply moving the lever 58, to its other extreme position. When the clutch element 50, is engaged with either one of the pinions 51 or 52, the periphery thereof is disposed to prevent inward movement of the spring detent 49, thus holding the lever 45, against movement into a release or unlatching position so that while the lower end 46, of the lever 45, is engaged in one of the notches in the top plate 48, of the casing 7, no adjustments of the housing 42, can be made while the wringer is under the operation of the power drive. In order to adjust or swing the wringer 44, the lever 58, must be moved into a vertical or neutral position, engaged by the spring detent 61, which tends to hold the same in neutral position, and permitting the inner end of the detent 49, to engage in the groove of the clutch element 50, by moving the upper end of the lever 45, toward the housing 42, thereby simultaneously disengaging the lower end 46, of said lever from engagement with one of the notches 47, of the plate 48, and allowing said lower end 46, of the lever to engage the periphery of the plate 48, in which position the upper end of the lever 45, holds the detent 49, in engagement with the clutch 50, thus preventing operation of the wringer. The housing 42, and the wringer 44, may now be swung through a horizontal angle to the position desired. The wringer mechanism and clothes drum mechanism may be operated simultaneously or independently of one another from the continuously driven shaft 26, when the detent 49, and the pin 35, are

in retracted position out of engagement with the respective clutch member 50, and the yoke arm 34. In the event of the wringer or clutch mechanisms becoming jammed during operation thereof, the mechanisms will not be damaged for the reason that the clutch mechanism 15—20, will slip when over-loaded to this extent.

I am aware that numerous details of construction may be varied through a wide range without departing from the principles of this invention, and I therefore do not purpose limiting the patent granted otherwise than necessitated by the prior art.

I claim as my invention:

1. In a device of the class described the combination of an adjustably mounted wringer, shiftable means for controlling the operation of said wringer, and a lock adapted to hold the shiftable controlling means of the wringer in a predetermined position during adjustment of the wringer and adapted to automatically release said controlling means when the wringer reaches a predetermined position of adjustment.

2. In a device of the class described, the combination of an adjustably mounted wringer, of shiftable means for controlling the operation of said wringer, a pivoted means for locking the wringer in position of adjustment and a member adapted to alternately lock the shiftable means and the pivoted means in position.

3. In a device of the character described, the combination with an adjustably mounted wringer, of shiftable means for controlling the operation of said wringer, locking means for holding the aforesaid shiftable means in a predetermined position, and locking means for holding the wringer in positions of adjustment, both of said locking means being interconnected so that when either is locked the other is capable of being released.

4. In a device of the character described, the combination of an adjustably mounted wringer, reversing mechanism therefor, means for locking the wringer in positions of adjustment, and a mechanism for locking the reversing mechanism in the neutral position actuated by the releasing operation of said locking means.

5. In a device of the character described, the combination of an adjustably mounted wringer, reversing mechanism therefor, means for locking the reversing mechanism in the neutral position, and means for locking the wringer in position of adjustment and interconnected with the first mentioned locking means so that each locking means is in locking position when the other is released.

6. In a device of the character described, the combination with an adjustably mounted wringer, of a shiftable mechanism for controlling the operation of the wringer, a spring controlled member for controlling the operation of said shiftable mechanism, and locking means operable by said spring controlled member for holding the wringer in position of adjustment, said locking means being non-releasable when the shiftable mechanism is in a predetermined position for driving the wringer.

7. In a device of the character described, the combination of an adjustable wringer, mechanism for operating the wringer in forward and reverse directions and shiftable to a neutral position to discontinue operation of the wringer, locking means for holding the wringer in positions of adjustment, and slidable means for non-releasably holding said locking means in locked position when said mechanism is moved from the neutral position.

8. In a device of the character described, the combination with a wringer pivoted about a vertical axis, and a driving member concentric with said axis, for operating the same, of means for making and breaking the operative connection between said member and wringer, means for locking said wringer in fixed position relatively to said vertical axis, and means preventing the making of operative connections between said member and wringer except when said wringer is locked.

9. In a device of the character described, the combination with a base, a vertical shaft journaled therein, a wringer pivoted for movement about a vertical axis concentric with said shaft, means for locking said wringer against movement about such axis, clutch means between said wringer and shaft, and means for preventing the operation of said clutch means until said locking means has been brought to operative position.

10. In a laundry machine, in combination, a base, a vertical shaft journalled thereto, a driving motor geared to said shaft, a support pivoted to said base upon an axis concentric with said shaft, a wringer secured to said support and projecting laterally therefrom, means for securing said support immovably to said base, and means including a clutch for connecting said shaft to said wringer, said means being so related that the second cannot be operated until after the first has been operated.

11. In combination a pair of hollow members pivoted together, a shaft concentric with the pivot axis and having a clutch associated therewith, a driven member journalled in one of said hollow members and adapted to be operated from said shaft when said clutch member is in engaging position, means for locking said first mem-

bers together, and means preventing the engagement of said clutch when said members are unlocked.

12. The combination with a base, of a support adjustably arranged on the base, a driven shaft and a driving shaft both journalled in said support, gears loosely mounted on the driving shaft and cooperating with the driven shaft to move it in opposite directions, a clutch slidable on the driving shaft into selective engagement with said gears, a retaining device acting to hold the support in adjusted position on the base, and interlocking means between the retaining device and said clutch whereby disengagement of the retaining device from the base is permitted when the clutch is in neutral position and prevented when the clutch is engaged with one of said gears.

13. The combination with a base, of a support adjustably arranged on the base, a driven shaft on the support, a retaining device acting to hold the support in adjusted position on the base, and means cooperating with said retaining device and acting to prevent its disengagement from the base when the driven shaft is running and to permit such disengagement when the driven shaft is idle.

14. The combination with a base, of a support rotatably mounted on the base, a wringer supported on said support eccentrically with reference to said axis of rotation of the support, a power shaft supported on the base and connected with the wringer in line with the axis of rotation of said support, a clutch connection interposed between the power shaft and the wringer, and means for holding the support against rotation on the base, said means preventing the release of the support while the clutch is connecting the power shaft with the wringer.

15. The combination of a base, with a clothes wringer support rotatably mounted on the base, a driven shaft journalled in the support, a driving shaft also arranged on the support, gearing connecting the driving shaft and driven shaft for moving the latter in either direction including oppositely arranged gears and a slidable clutch member movable selectively into engagement therewith, a retaining device acting to hold the support in adjusted position on the base, and locking means between said clutch member and retaining device acting to hold the latter engaged with the base when the clutch member is engaged and adapted to permit release of the retaining device when the clutch member is in neutral position.

In testimony whereof I have hereunto subscribed my name in the presence of two subscribing witnesses.

HAROLD W. EDEN.

Witnesses:
FRED E. PARKER,
CHARLES W. HILLS, Jr.

THE EDEN DEVICE.

Fig. I diagrammatically shows the gearing construction disclosed in the Eden patent by which the rolls of a wringer can be driven in either direction or stopped at the pleasure of the operator, and a locking latch 46 for holding the wringer in various positions of adjustment with respect to the washing machine on which it is mounted. There is a grooved clutch 50 mounted between two opposed gears 51 and 52 on a driving shaft (connected to the washing machine motor) which are always in mesh with a gear 53 mounted on the lower wringer roll shaft. When the clutch is shifted into clutching engagement with the bevelled gear 51 the wringer rolls are driven in one direction, and when shifted into clutching engagement with the bevelled gear 52 the wringer rolls are driven in the opposite direction, and when the clutch is in neutral position (as shown in the cut) the wringer rolls remain idle. All of this construction was old and well known long prior to Eden. One illustration of this is shown in the prior art Lyche patent No. 1,209,981 of December 26, 1916 (R. 916), a cut of which is reproduced as Fig. II of this chart.

To this old device Eden simply added a spring pressed pin 49 mounted in the gear casing between the handle 45 of the locking latch 46 and the grooved clutch 50 for normally holding the latch in locked position, so that the wringer would not swing while the wringer rolls were being driven.

When the clutch 50 is in neutral position the locking latch handle can be swung inwardly to permit this latch to be reelased as this pin can then enter the groove of the clutch. When the clutch is in either of its driving positions one of the peripheral flanges of the clutch will be in position to prevent the pin or handle from being moved inwardly or the latch unlocked. Eden's sole feature of novelty resided in so mounting an old spring pressed pin in the gear casing of an old type of gearing between the handle of the latch, which prevented the wringer from swinging while the rolls were being operated, and the clutch for driving the wringer rolls in either direction, in such a way that the locking latch could not be unlocked or the wringer swung while the wringer rolls were in operation. It is solely upon the mounting and use of this spring pressed pin to provide an interlock between these two movable parts that each of the claims of the Eden patent in suit depend for novelty.

DEFENDANTS' DEVICE.

Fig. III diagrammatically shows the Maytag construction charged to infringe. This had been made and sold extensively, to the knowledge of plaintiff and its predecessors, nearly seven years before any claim of infringement was made by either, and it is radically different from Eden both in construction and operation.

The Maytag construction utilizes an entirely different old type of gearing construction for controlling the operation of the wringer rolls and a radically different kind of interlock from that disclosed in the Eden patent.

In this construction two gears 3 and 4 are secured together by a collar 5, which is slidably mounted on a squared portion 6 of the wringer roll shaft 7, so that when either of these gears are engaged by the driving gear 1, mounted on the driving shaft 2, the gears and the shaft on which they are mounted will be driven to drive the wringer rolls, the direction of rotation depending upon whether bevelled gear 3 or 4 is engaged by the bevelled gear 1. In neutral position, the gears 3 and 4 are out of mesh with the gear 1 and the wringer rolls will remain idle.

In this construction a vertical locking pin is mounted in the gear casing in such a way that its lower end will engage any one of a series of notches 9 in the locking plate 10 and will normally hold the wringer against swinging movement. The gears 3 and 4 are shifted through a yoke 16 which spans them. This yoke is connected with a collar 14, by an eccentric pin 15. This collar is mounted on a stub shaft 13 in the upper portion of the gear casing. A single handle 11 is secured to the upper end of shaft 13 so that by movement of it in one horizontal direction gear 3 will be shifted into engagement with gear 1 and the wringer rolls will be driven in one direction. By shifting handle 11 in the opposite horizontal direction gear 4 will be shifted into engagement with gear 1 for driving the wringer rolls in the opposite direction.

A pivoted lever 18 is mounted in the gear casing beneath the collar on which the single control handle is mounted in such a way that its inner end engages this collar and its outer end enters a notch in the upper end of the locking pin 8, so that when the gears 3 and 4 are in neutral position, out of engagement with the driving gear 1, the single control handle 11 can be moved downwardly, to press the inner end of the pivoted latch 18 downwardly and raise its outer end, thereby lifting the

locking pin. When the single control handle 11 has been moved to a position to cause either of the bevelled gears 3 or 4 to be moved into contact with the driving gear 1, this handle cannot be pressed downwardly, and for this reason the locking pin cannot be released to swing the wringer at that time.

In the Maytag device there is no grooved or other clutch, no pivoted locking latch, and no spring pressed pin between the handle of the locking latch and the clutch, all of which are essential to the construction and operation of the Eden device.

In the Maytag device there is but a single handle control, whereas in the Eden device there are two control handles, both of which are necessary to the operation of that device.

A comparison of the structure disclosed in the Eden patent and that of Maytag makes apparent the radical differences between the two and the lack of equivalency of the means employed for securing an interlock between the wringer rolls and the mechanism for preventing the swinging of the wringer while the wringer rolls are in operation.

FIG. I.

DEVICE OF EDEN PATENT.

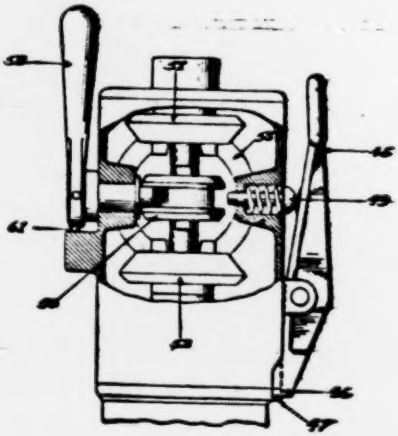


FIG. II.

H. H. LYCHE.

GEARING FOR WASHING MACHINES.

APPLICATION FILED JAN. 20, 1916.

1,209,981.

Patented Dec. 26, 1916.

2 SHEETS—SHEET 1.

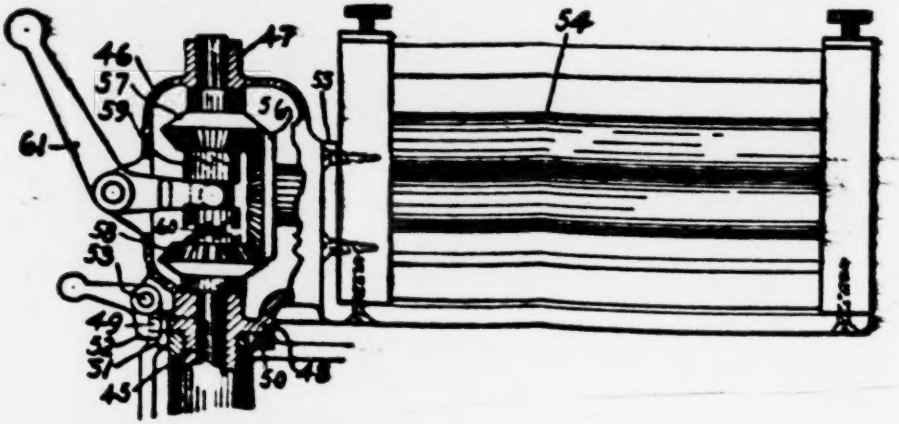
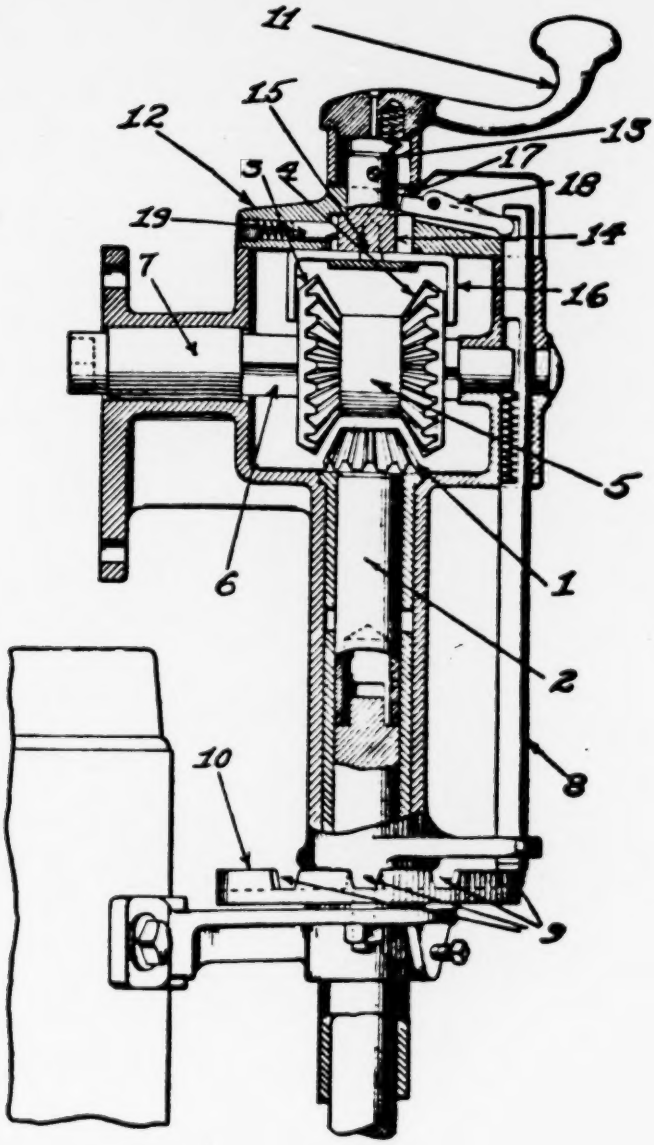


FIG. III.

DEFENDANTS' DEVICE.



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No. 703.

THE MAYTAG COMPANY AND
MAYTAG SALES CORPORATION,
Petitioners,

vs.

THE APEX ELECTRICAL MANUFACTURING COMPANY,
Respondent.

BRIEF FOR RESPONDENT ON THE PETITION FOR WRIT OF CERTIORARI.

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In the Supreme Court of the United States

OCTOBER TERM, A. D. 941.

No. 703.

THE MAYTAG COMPANY AND
MAYTAG SALES CORPORATION,
Petitioners,

vs.

THE APEX ELECTRICAL MANUFACTURING COMPANY,
Respondent.

BRIEF FOR RESPONDENT ON THE PETITION FOR WRIT OF CERTIORARI.

The Respondent herewith respectfully points out the reasons why, in its opinion, the present Petition should be denied:

(1) There is no diversity of decision between Courts of Appeals below (*Keller v. Adams*, 264 U. S. 311, 314; *Layne v. Western Well*, 261 U. S. 387, 393.)

(2) There is uniformity of decision in the Second and the Seventh Circuits below. The decision of the Court of Appeals in the Seventh Circuit, 122 Fed. (2) 182 is in accord with the decision of the District Court in Connecticut in *The Apex Electrical Manufacturing Company versus Landers, Frary & Clark*, 21 F. S. 241.

(3) There is no diversity of decision between the Court of Appeals in the Seventh Circuit and the District Court in the instant case. On the contrary, the two are in accord. This Court has recently declined to grant certiorari in many such cases (see *Ace v. Exhibit*, 119 Fed. (2)

349; certiorari denied October 14, 1941; *Killian v. Dean,* 308 U. S. 624; *General v. Fisk,* 308 Fed. (2) 581).

(4) No question of public interest is involved; petitioners show no other unlicensed infringer than petitioners. Therefore, *Schriber-Schroth v. Cleveland Trust,* 305 U. S. 47 is not applicable. On this record the interest is limited to the litigants.

(5) The patent in suit has expired and, therefore, the only thing involved is the amount of the recovery. This makes the controversy purely private to the parties. Indeed, a patent controversy could not be more local and of less public interest than one such as the instant controversy where the only thing involved is the amount of the judgment.

(6) The litigation over the patent in suit has not been confined to one Circuit, as in the *Schriber-Schroth* case.

(7) The sole purpose of the Petition is to challenge here the rightness of the concurring findings of fact of the District Judge in Connecticut, the District Judge in Indianapolis, and the Court of Appeals in the Seventh Circuit on hearing and rehearing.

(8) The specific questions presented to this Court were all fully presented and ruled upon by each of these Courts below.

(9) The Findings challenged are Findings of Fact in which all three Courts are in accord.

(10) The Court of Appeals not only decided the issues on the basis of Rule 52, but decided them independently of Rule 52.

(11) Each of the District Judges saw and heard the witnesses who gave the testimony upon which the Findings of Fact are based; the District Judge in the instant case saw the machines and their operation.

(12) All Courts applied the rules of identity, substantial identity and equivalency as announced, rean-

nounced and applied by this Court in decisions all the way from *Winans v. Denmead*, 15 How. 330 to *Smith v. Snow*, 294 U. S. 1.

(13) The claims are not functional; they classify with the claims sustained by this Court in *Bassick v. Hollingshead*, 298 U. S. 415 and not with the claims in *General Electric v. Wabash*.

(14) There is no laches; there is no law question involved; the law principles followed are ancient and standard; the question is one of fact in which all three Courts below are in accord.

While this Court undoubtedly has jurisdiction and the right to grant the Petition for Certiorari, this Court has said that it would not grant certiorari in a patent case involving only questions of invention, breadth of claims, and the like. Thus in *Keller v. Adams-Campbell*, 264 U. S. 314, 319, this Court said:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent."

This Court has also said it would not take up a case to settle principles important to the parties, but unimportant to the public. Thus, in *Layne and Bowler Corporation v. Western Well Works*, 261 U. S. 387, the Court said (p. 393):

> "If it be suggested that as much effort and time as we have given to the consideration of the alleged conflict would have enabled us to dispose of the case before us on the merits, the answer is that it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal."

This Court has also said that it would not grant certiorari to review concurring decisions below (*Thompson Spot Welder v. Ford Motor Company*, 265 U. S. 445).

In *General Pictures v. Electric*, 304 U. S. 175 this Court said (pp. 178-179):

> "Moreover, the decision on that point rests on concurrent findings. They are not to be disturbed unless plainly without support. *United States v. Chemical Foundation*, 272 U. S. 1, 14. *United States v. McGowan*, 290 U. S. 592. *Alabama Power Co. v. Ickes*, 302 U. S. 464. There is evidence to support them. Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals. *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393. *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319-320. Cf. *Stilz v. United States*, 269 U. S. 144, 147-148."

In the *Schriber-Schroth* case there was diversity of decision below, the Court of Appeals in the Sixth Circuit being in disagreement with the Master and the District Judge. Moreover, the patents involved were still extant and litigation had been, and this Court thought, as we understand it, that litigation would be confined to the Sixth Circuit. In the instant case the patent has been litigated in the Second and Seventh Circuits.

The rule of respect for concurring decisions of Courts below who saw and heard the witnesses announced a long time ago by this Court in *Adamson v. Gilliland*, 242 U. S. 350, has now been given the force of law under Rule 52 of the Federal Rules of Civil Procedure and extended to the Courts who saw the machines and their operations.

I.

SUMMARY STATEMENT OF MATTER INVOLVED.

The Petitioner, the Maytag Company, was the prime mover and the principal in the organization, the promotion and the execution of a patent "pool"; a collateral patent came to this Court in *Maytag v. Hurley*, 307 U. S. 241 (R. pp. 571, 588; D. E. 67 and 69). Respondent, Apex, paid Four Hundred and Fifty Thousand Dollars ($450,000.00) in royalty into this "pool" (R. p. 118). The patent pool not only exacted these royalties, but imposed such other conditions that a relative newcomer in the field, such as the Respondent, was relegated to purchasing patents to acquire meritorious equipment to meet the competition of the Maytag Company (R. p. 104). Among the patents purchased in this connection by Respondent was the Eden patent in suit (R. p. 104) which disclosed an invention of great merit (R. p. 1022) and which has been incorporated in hundreds of thousands of machines sold and used throughout the country (see Finding No. 6; R. p. 760, and R. pp. 119, 118, 125, 127, 128 and 225). The claim to the contrary is one of the inexcusable errors in the Petition. While the Maytag Company was exacting tribute from others under its patents, it disregarded the patent rights of these others, including the rights of Respondent, and hence this suit, a purpose of which might, in effect, be said to be an effort to recover for the use of the Respondent's patent rights by the Maytag Company some of the royalties paid under the Petitioner's patents into the pool by the Respondent.

The owners of the Eden patent, prior to the purchase by Apex, did not know that Maytag was making the infringing construction or infringing the patent. Repeated assertion in the Petition to the contrary is the second inexcusable error of the Petition (R. pp. 123, 124, 125 and 131). At the time the Respondent purchased the Eden patent, Respondent did not know that it was being infringed by the Petitioner (R. p. 104). Hence the fallacy of the claim re-

peatedly made by the Petitioner that the case is predicated upon speculation by the purchaser of the patent.

The witness, Hess, was not asked leading questions; the questions asked were not objected to. Mr. Hess testified not only that he did not know that Maytag was infringing, but he did not know what features were made by Maytag that constituted the infringing constructions. On the latter subject he testified particularly at page 131 of the record, explaining that he no more knew what was inside the Maytag casing than the ordinary person knows what is inside of an automobile, though one might know all about the outside of the automobile. The record further shows that Mr. Hess not only testified to these facts on the witness-stand, but he told them to the Petitioner before he went on the witness-stand when the Petitioner inquired of him about them, intending to place him on the witness-stand, which the Petitioner did not do after learning that the evidence was against the Petitioner (R. pp. 125 and 131).

As soon as the patent had been acquired by the Respondent, the Maytag Company was notified of the infringement. The delays in the prosecution of the instant suit mentioned in the Petition resulted from the prosecution of a similar suit in the Second Circuit, the taking of depositions here, and the conveniences of Court and counsel. In other words, Respondent recognized the authority which holds that a patentee is not required to proceed with two suits on the same patent at the same time, but should wait in the one case until there is an adjudication in the other case (*U. S. Fire v. Wisconsin,* 290 Fed. 171, 173 (C. C. A. 7); *Tompkins v. St. Regis,* 236 Fed. 221, 225 (C. C. A. 2); *Stearns v. Brown,* 114 Fed. 939, 945 (C. C. A. 8); *U. S. Mitis v. Detroit,* 122 Fed. 863, 866 (C. C. A. 6)). All during the prosecution in the Connecticut suit the Petitioner was under notice of infringement and familiar with the proceedings in the Connecticut suit. The Connecticut

suit was brought to trial in due time. The decision is reported at 21 F. S. 241 and was handed down November 10, 1937, holding the Eden patent valid and infringed against the defenses here presented, including laches. This feature of the cause was settled and the balance was appealed, resulting in a per curiam affirmance in the Second Circuit Court of Appeals (100 Fed. (2) 1009). In view of the affirmance by the Court of Appeals of all other parts of Judge Thomas' decision, we are willing to concede that Respondent made a mistake in settling the Eden branch for what Petitioner calls "a nominal sum." With the Second Circuit litigation cleared away, the parties proceeded to trial in the instant cause as fast as taking depositions and conveniences of counsel and Court permitted.

The trials, both in Connecticut and Indianapolis, were had in open Court where the District Judges saw and heard the witnesses and saw the demonstrations of the machines. The prior art submitted in the two cases was the same except that in the District Court in the instant case the so-called Schroeder machine was produced and offered by the defendant. However, upon its being found to be spurious by the District Court (R. p. 760), it was rejected, so that the art before the two District Courts was the same.

Even defendant's expert paid tribute to the Eden invention, testifying that Eden solved a problem which had not been solved by anybody else (R. pp. 281 and 286). The District Judge found, *inter alia*, that Eden solved a problem and filled a need which had long existed; that others skilled in the art prior to Eden had attempted and failed to solve this problem; that Eden's invention had met with public adoption and use and commercial success; that plaintiff's predecessors had no knowledge of the infringing construction; that there were no laches; and that the accused device was the full equivalent of the Eden patented device (R. pp. 760 and 761). These Findings and Conclusions were in substantial accord with those of the District Court in Connecticut.

The cause went to the Court of Appeals of the Seventh Circuit who affirmed the District Court in Indianapolis and the District Court in Connecticut, both on the Court's independent judgment and under Rule 52 and the provisions in the cases preceding Rule 52 and upon which it was founded, and especially upon those decisions which accredit weight to the finding of a District Court who saw the machines operated, as well as who saw the witnesses. The Court of Appeals, however, was not content to rest its decision upon Rule 52, but came to an independent conclusion as well. For example, take the excerpt quoted at page 7 of the Petition from record page 1025. Here the Petitioner quotes only the portion of the opinion of the Court of Appeals discussing infringement in connection with Rule 52. However, the Court also said, by way of coming to the same conclusion independently of Rule 52 (p. 1025):

> "However, we have here substantial identity both in combinations and in elements, and it seems to us that equivalency is obvious. We think there was no error in holding the claims infringed."

In these premises it does not matter whether the rule as stated in F. R. C. P. 52, or the rule in *Singer v. Cramer,* applies. In other words, it does not matter whether infringement in this case is predicated upon fact or law though, of course, it is predicated upon fact. The law of equivalency is well understood. The sole question was whether or not the performance of the machines was according to that rule of law. As the District Judge not only heard the witnesses, but saw the machines operated, the situation would seem to be the very kind of a situation that the promulgators of Rule 52 had in mind and the Courts, in a host of decisions, had in mind prior to the promulgation of that rule (see, for example, *G. M. v. Swan,* 44 Fed. (2) 24 (C. C. A. 6) and *Stevens v. Schmid,* 73 Fed. (2) 54 (C. C. A. 2)). The rule, of course, is not peculiar to patent law but, as is well recognized, is generic throughout the

law and results from the recognized superior opportunity of the Court who sees and hears the witnesses and sees the machines and their operations to ascertain and determine the facts.

The Court of Appeals did not decline to review the holding of the District Courts on the question of laches. On this subject the Court said, *inter alia* (R. p. 1025):

> "*These were all questions of fact and were sharply contested.* There was substantial evidence in support of the lower court's finding and we can not disturb it. The same question was presented in the *Landers* case, *supra*, and a like finding was made." (Emphasis ours throughout unless otherwise indicated.)

On the general subject of the opinion of the District Courts, the Court of Appeals expressed its position as follows (R. p. 1022):

> "*Of course, our decision should not be, and it is not based alone on this coincidence of opinion.* However, the record in this case and the opinion in the *Landers* case are quite convincing that both cases were well tried and thoroughly considered."

The substantial evidence referred to is recited by us hereafter in this brief. However, Petitioner's method of attacking one important item of this evidence by accusing the witness of knowing of the infringement and the character of the infringing apparatus when he testified positively that he did not know either, emphasizes the propriety of the acceptance by the Court of Appeals of the decision of the District Judge as to the credibility of the witness, Hess, against the dissent of the Petitioner on the subject.

With respect to the statements in the paragraphs numbered (1), (2), and (3) on pages 4 and 5 of the brief, we say here succinctly, while reserving more extended discussion until later, as follows:

(1) Respondent's predecessor did not know that Petitioner was making or selling the construction held to in-

fringe, as Petitioner well knows. Not only have the Courts found this to be true (R. p. 761), but the witness, Hess, the President of this predecessor concern, not only testified to that effect on the witness-stand, but told Petitioner prior to testifying that he did not know it when Petitioner interviewed him for the purpose of making him his own witness on the subject.

(2) As all the Courts have held, the feature of novelty was in the new combination of elements in the claims. This constituted the invention. The function to which reference is made is not the invention, but one of the things the invention does. Its addition to the claim was gratis and added nothing to the novelty. A claim is not invalid because it recites a function in addition to reciting the elements constituting the combination. The claims are like those held valid by this Court in *Bassick v. Hollingshead,* 298 U. S. 415, 420 as distinguished from the claims in *General Electric v. Wabash,* 304 U. S. 364.

(3) Instead of the defendant's device being radically different from the patented device, it is substantially identical and the full equivalent, as the record shows, and each of the Courts have held. While it is true that the infringing device performs the same function as the patented device, that is not the only feature of identity. There is identity of structure and operation as well as function.

It is plain from this statement of facts that there is nowhere any diversity of view among any of the three Courts which have ruled upon issues here involved or between the two Courts who have ruled upon all of the issues involved. It is also apparent that no new question of law is presented in this case and that the controversy is purely local between the parties. It is also apparent from the Petitioner's complaint that it is predicated upon errors of fact and upon misinterpretations by Petitioner of established law.

Questions Involved: All the questions included under this title at pages 8 and 9 of the Petition are local to this litigation. There is no discord below with respect to any of them. On the other hand, there is concord throughout. In addition counsel is in error with respect to each of them, as we have already shown.

(1) The Court of Appeals did not refuse independent determination of the question of laches and infringement, though it may have properly done so, under the provisions of Rule 52, since both questions were predicated upon facts found by one or two District Judges who saw and heard the witnesses and saw the operations of the machine.

(2) and (4) The claims are not functional, as all three Courts have found.

(3) Machines involving the Eden invention have been made and sold by the hundreds of thousands; the patent was purchased by the Respondent because of the merit of the invention which it covered and not for purposes of speculation though, of course, it would be immaterial if the purchase had been made for the latter proposition. The Statute awards the patentee the profits and damages of the infringer without inquiring as to whether the patent owner purchased the patent for reasons which were approved or disapproved by the infringer.

II.

The "reasons for granting the Writ" which are urged constitute no more than a repetition of what has already been said in the Petition. Our answers are the same. All of these reasons are esoteric to these parties; all are decided by concurring decisions below; there is no diversity of decision with respect to any of them. In addition counsel is wrong and the Courts are right about them for the reasons we have already given.

ARGUMENT.

I.

Anybody would think from the protestations and appeals of the Petitioner that the practice under F. R. C. P. 52(a) was a new practice, needing interpretation, explanation or application by this Court. Quite the contrary is true for the practice and its application is very old. All the rule did was to codify it. In that respect it differs from Rule 35, interpreted by this Court in *Sibbach v. Wilson*, 312 U. S. 1. The practice under F. R. C. P. 52 is a salutary rule for the reasons stated by Mr. Justice Holmes, speaking for this Court in *Adamson v. Gilliland, supra*, as follows (p. 353):

> "Considering that a patent has been granted to the plaintiff the case is pre-eminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' *Davis v. Schwartz*, 155 U. S. 631, 636."

Not only is the rule of ancient origin and frequent application, but it applies as well to findings predicated upon the observation of the machines and their operation (*Piper v. Brown*, Fed. Cas. 11,181 and authorities cited; *Diamond v. Webster*, 249 Fed. 155 (C. C. A. 9); *Stevens v. Schmid, supra; Swan v. General Motors, supra*).

Hereinafter we follow the order in Petitioner's Brief.

The facts in connection with the question of laches are as follows:

Facts prior to knowledge and Notice of Infringement in 1934: The application for the Eden patent was filed in 1917 and after a scrutinizing and intensive prosecution in the Patent Office, including two interferences, the Eden patent was issued in March, 1922. As shown on the patent it was issued after mesne assignments to the Gillispie-

Eden Company. The record shows that the title to the Eden invention passed through a series of small companies, all struggling for survival and to avoid bankruptcy in a sea dominated by large and belligerent competitors. In 1934 the plaintiff was in the market for and purchasing patents on meritorious devices in order to bolster its efforts to survive against this same competition and, among others, purchased the Eden and the Couch & Wallace patents in suit.

Prior to 1934 the owners of the Eden patent were so strapped by their efforts to keep out of bankruptcy that they were unable to purchase the equipment of their numerous competitors to determine whether or not their patents were being infringed (R. p. 134). The Eden Companies manufactured many machines employing the Eden invention prior to 1934 (R. pp. 125, 127, 128). They stressed the Eden invention (R. p. 125) and issued circulars showing machines employing the invention with an epigrammatic description thereof (R. pp. 581 and 597). Some of these circulars were in the possession of the Maytag Company and were taken out and studied by Maytag employees together with Eden machines, along in 1926 or 1927, just about the time the defendant's infringement of the Eden patent began (R. p. 250). The statements in these circulars announcing the incorporation therein of the feature covered by the Eden patent were read by the defendants' representatives and the devices themselves were seen (R. p. 251). Whether the machines issued by these companies embodied the Eden invention, or not as Petitioners contend, or were marked with the Eden patent date or not is not established by this record.*

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* Defendants' Vice President claimed to have secured one of these old machines and said that he failed to find such patent marking on the machine. Objection was made to his testimony regarding the contents of this document, and demand was made that he produce the exhibit, but he declined to do so, and the

(Continued on page 14)

On August 25, 1921, the owner of the Eden patent took a license under certain washing and wringing machine patents owned by the defendant. Thereafter The Maytag Company kept over the owners of the Eden patent that surveillance which a royalty collecting licensor always exercises over his licensees and their product to assure himself that none of the structure of the licensee avoids the patents covered by the license. In the instant case the supervision exercised by The Maytag Company over the owners of the Eden patent was unusually careful owing to the nature of the license which was limited to special designs (Defs. Ex. 66, R. p. 561, offered R. p. 114; Defs. Ex. 69, R. p. 588, offered R. pp. 222, 288).*

The record shows that the defendants began their infringement in 1927, about the time it learned of the claimed and challenged use of the invention of the Eden patent in the Eden machine through the Eden circulars (R. p. 251). That the defendant was conscious of its infringement is manifested in several ways; first, although it issued literally billions of advertisements explaining in great detail its washing and ironing machines and their merits, great care was exercised not to include any pictures or any words which would create any sus-

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(Continued from page 13)

Court overruled the request. The witness then testified that the markings were so indistinct that he could not tell what was said in these markings (R. pp. 253-255).

In addition, the Eden companies were bound by their licenses to mark their wringers in the form prescribed by The Maytag Company and to limit the marking to simply the patents under which they were licensed (R. p. 590; Defs. Ex. 69, offered R. pp. 222, 288) so that if the patent in suit was omitted it was as much the responsibility of defendants as of the Eden companies.

* This restriction of the licensees to the antiquated machines for which the licenses were originally granted was actually enforced by The Maytag Company. See *Vulcan vs. Maytag*, 73 Fed. (2) 136, 139. It was attempted to be enforced against plaintiff until The Maytag Company was perpetually enjoined from suing plaintiff on this ground (R. p. 538; Pl. Ex. M-8, offered R. p. 93).

picion that the defendant was employing the Eden invention; second, the mechanism involving the invention was included within a casing whose parts were tightly screwed together so that no one would suspect that the Eden invention was being employed unless he unscrewed the casing, opened up the parts, and then operated the mechanism. That the purpose of these proceedings was to hide the infringement is manifested by the fact that soon after the owners of the Eden patent discovered that the defendant was infringing the patent, and the defendant learned of that discovery, the defendants' advertisements thereafter contained laudatory statements regarding the merits of the Eden invention involved in the defendants' machine (Exhibit I, R. p. 521; first published June, 1936, R. p. 79).* So effective was the concealment that the plaintiff didn't know that Maytag was using the infringing equipment when plaintiff acquired the Eden patent in 1934 (R. p. 104) though the plaintiff had been operating under the same kind of a Maytag license as the Eden people to a $450,000 extent (R. p. 118).

In view of the careful concealment of the infringement by the defendant, the Eden people had no way of learning of the infringement except by one of the following three ways:

First, to send somebody around with a screw-driver and investigate washing machines in all the cellars of all the residences;

Second, take the screw-driver and go around to all of the stores or other places where the defendants' machines were on sale and open one up, or

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* The reproduction of this document in the record (R. p. 521) is so badly done that the small type printing matter cannot be read. The following appears—legible enough in the original document—below the picture in the upper righthand corner:

"Rolls cannot be started until wringer is locked in position."

Third, buy up and investigate a specimen of each of the washing and wringing machines on the market at an expense of $25,000.00 or $30,000.00.

Nor would the use by the defendant of a single lever create any suspicion as defendants contend in their brief because there had been and were upon the market many machines employing a single lever, such as the Schroeder machine, which not only did not employ the Eden invention, but which could not short of some legerdemain be modified to employ it. There were also upon the market many machines which, though they employed two levers, placed one of them in a prominent position, as the infringing machine placed its lever, and placed the other in an obscure or suppressed position in order that the prominence of the former would assure its position of neutrality before the suppressed lever was operated in order to avoid the accidents which the Eden invention made impossible. Machines employing this stratagem are illustrated in the Lyche patent and the Mammen patent, and in machines of defendants preceding the infringement. One accustomed to looking at such a machine where the lever on the upper righthand side is shown with great prominence and the second lever is hidden in the nether parts of the apparatus, would hardly be stirred to suspicion by a machine which omitted the suppressed lever altogether.

Proceedings After 1934 When the Plaintiff Acquired the Eden Patent: In 1934: Plaintiff acquired the Eden patent on April 18th (R. p. 495; Pl. Ex. B-10, offered R. p. 92); thereafter, the defendants' infringement was discovered (R. p. 104); June 9th, Maytag was notified of its infringement (R. p. 529; Pl. Ex. M, offered R. p. 92); June 16th, plaintiff counterclaimed the defendant on the Eden patent (R. p. 530; Pl. Ex. M-1, offered R. p. 92); June 27th, plaintiff advised defendant Eden claims infringed (R. p. 532; Pl. Ex. M-2, offered R. p. 92).

1935: January 21, the District Court ordered the dismissal of the counterclaim "without prejudice" (R. p. 538; Pl. Ex. M-8, offered R. p. 93); February 14th, such counterclaim was so dismissed (R. p. 540; Pl. Ex. M-9, offered R. p. 93).

1936: February 18th, suit was instituted in the Second Circuit under the Eden and other patents (R. p. 696; Def. Ex. 87, offered R. p. 289); filing of the bill was preceded by the usual preparations which precede the institution of all suits; November 25th, further notices of infringement were served by the plaintiff on defendant; depositions were taken in the Second Circuit suit which proceeded to trial in the usual way and with the usual activities; the instant suit was instituted on December 7th (R. p. 1); December 11th, amended Bill was filed (R. p. 12), and from then on until the trial of this suit overlapping activities on these two suits, one pending in the Second Circuit and the instant cause, were continued with great activity as follows:

In 1937: In this suit Motion for and Bill of Particulars was filed early in the year; April 23rd, an Order was entered on the particulars and supplemental and amended bill incorporating particulars was filed (R. p. 36); defendant filed its Answer on June 21st (R. p. 56). In the meantime the case in the Second Circuit was tried and on November 10th Judge Thomas handed down his opinion holding the Eden patent valid and infringed.

In 1938: The decree in the Connecticut case, holding the Eden patent valid and infringed, was entered on January 5 (R. p. 427; Pl. Ex. A-24, offered R. p. 93). During the remainder of 1938 the issue over the Eden patent was negotiated and settled in the Second Circuit case; appeal was then prosecuted from the other parts of the decree, including the Prachar patent, and heard by the Circuit Court of Appeals in the Second Circuit and decided on December 19th (100 F. (2) 1009). In the instant cause stipulation

was prepared and filed February 8th (R. p. 73); defendants' answer was amended May 21st (R. p. 74) and a second stipulation filed May 28th (R. p. 77).

In 1939: Depositions of nine witnesses were taken by defendants in the instant cause in February (R. pp. 136, 381); on March 10th plaintiff filed requests for Admissions (R. p. 80) and on March 18th plaintiff amended its Bill (R. p. 82); on May 1st, the case was set for trial in June (R. p. 83); June 1st, amendment to Bill of Complaint was filed (R. p. 85) and on June 14th, amendment to defendants' Answer (R. p. 86); June 14th, the trial was postponed until September 26th (R. p. 87); June 24th, defendants amended their Answer (R. p. 88); and the trial began on September 26th (R. p. 90). In the meantime nineteen depositions had been taken by both parties (R. pp. 136-137) and both parties were otherwise active in the suit.

Through all this time it is a fair presumption that there were the usual extensions of time to accommodate courts and counsel.

Many of these facts were in dispute including the credibility of the testimony of Mr. Hess to which we have already referred.

Substantially all the facts included in the items 1 to 5 on pages 15 and 16 of Petitioner's brief were in dispute. Among these facts were the following:

The relationship was not close; the circulars referred to did not disclose the infringing apparatus; on the other hand, they concealed it; that the Maytag machines advertised, manufactured and sold throughout the country employed the infringing apparatus, was not only not known to the owner of the Eden patent, but was concealed by the Maytag Company; the single handle control was not a conspicuous feature of the infringing machines; it was not emphasized in the circulars; on the contrary, it was suppressed; the presence of the single hand control, instead of giving any indication of infringement, was misleading

on the subject because of the use of the single hand controls in other machines, including the spurious Schroeder machine. It would have been illegal to have marked any machine under the Eden patent which did not employ the Eden invention, and Petitioner asserts that the owners of the Eden patent, prior to the Respondent, did not make any machines under the patent. The markings to be placed upon these machines were dictated by the Petitioner under the licensing arrangement under its pool of patents. The Maytag Company knew about the Eden patent and that it was being infringed by the accused machines all during the period it was making and selling them.

Many other of the many facts which we have listed above are in dispute. Concerning some of them the evidence is in conflict. The District Court saw and heard the witnesses offering this evidence and resolved it in favor of the Respondent.

Certiorari was granted in *Chandler v. Brandtjen*, 296 U. S. 53, on the grounds of diversity of decision between the Second and the Seventh Circuits. We have discussed the reasons for granting certiorari in *Sibbach v. Wilson*, *supra*.

II.

The discussion of infringement by the Court of Appeals is found in the following excerpt (R. pp. 1024 and 1025):

> "Patents are not limited to the structure described and shown, but the invention may be embodied in various forms. A transposition or rearrangement of the parts as set forth in a patent is an embodiment of the patented invention and does not avoid infringement unless form, location or sequence is essential to the result or to the novelty of the claims. *Continental Paper Bag Co. v. Eastern Paper Bag Co., supra; Simplex Co. v. Star Co.*, 37 F. 2d 491. Infringement is not avoided by combining two elements of a claim in one

part. *Bundy Mfg. Co. v. Detroit Co.*, 94 Fed. 524; *Dowagiac Co. v. Brennan & Co.*, 127 Fed. 143.

"*We think there can be no doubt that each of the asserted claims reads upon defendants' structure*, and the only seemingly important difference between the patent disclosure and the accused structure lies in the fact that defendants use one lever which performs the same function, in the same manner, and accomplishes the same result, as do Eden's two levers. *The District Court found equivalency, and we agree.*

* * * * *

"It is argued by appellants that in *Miller v. Eagle Co.*, 151 U. S. 186, it was held that interchangeability is a test of infringement, but *under the facts there present* we think it is clear the Court referred to functional rather than physical interchangeability. This would seem to be true in the light of more recent decisions. *Continental Co. v. Eastern Co., supra; Hildreth v. Mastoras*, 257 U. S. 27; *Eibel Co. v. Paper Co., supra*; and *Sanitary Co. v. Winters*, 280 U. S. 30.

"Of course, as defendants urge, there can be no infringement without substantial identity, and the mere reading of the claims upon the accused structure does not connote infringement unless there is equivalency. *However, we have here substantial identity both in combinations and in elements, and it seems to us that equivalency is obvious.*"

Thus the Court of Appeals not only found that the claims in suit described the defendants' construction, but found equivalency independently of the District Court who had also found equivalency.* The Court of Appeals also found substantial identity in structure ("in combinations and in elements") as well as in operation and results ("per-

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* The finding of the District Court on the subject is as follows (R. p. 760):

"7. The defendants' machines exemplified by Plaintiff's Exhibits A and B embody all of the elements of the combination of the claims in suit of the Eden patent, and operate in substantially the same way to get the same results."

forms the same function, in the same manner, and accomplishes the same result"). This is in accordance with the rule that has existed from time immemorial in the patent practice. It has been applied by this Court frequently. For example, in the *Paper Bag Machine* case, 210 U. S. 405, this Court said (pp. 418 and 419):

> "An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth. 'The principle of the invention is a unit, and invariably the modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other.' *Robinson on Patents,* Sec. 485."

In the *Sanitary v. Winters* case, the Supreme Court said, 280 U. S. 42:

> "A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement. *Ives v. Hamilton,* 92 U. S. 426, 430. And even where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee and cannot be extended to embrace a new form which is a substantial departure therefrom, it is nevertheless infringed by a device in which there is no substantial departure from the description in the patent, but a mere colorable departure therefrom. Compare *Duff v. Sterling Pump Co.,* 107 U. S. 636, 639."

The discussion of infringement by the Court of Appeals and the finding of the District Court in the above quotations show that there is plain mechanical equivalency between the elements in the defendants' and the patented machine as in the *Eibel* case, and that the corresponding elements operate upon the same principle and get the same results as in the *Hildreth-Mastoras* case, and that the difference is, therefore, merely colorable as in the *Sanitary-Winters* case, since these differences are merely

mechanical details which leave the principles the same. Since the Court of Appeals found that there was substantial identity both in combination and in elements, there was similarity in elements in the instant case, and hence the rule in *Jogger v. Ropemore* does not apply, since there, as Judge Evans said, similarity of elements was absent. The rule in *Westinghouse v. Boyden* does not apply because, in the instant case, both Courts found that there was substantial identity in principle, in elements and in results. The Court of Appeals distinguished from *Miller v. Eagle* under the facts here as distinguished from the facts there presented.

In the other Seventh Circuit cases relied upon by the Petitioner, non-infringement was found because the claims had been limited for reasons such as file wrapper estoppel, the prior art in those particular cases, or on the paper patent theory, none of which are present in the instant case. Due to the extensive use and practical success of the Eden invention, the rule as stated in *Smith v. Snow,* 294 U. S. 14 as follows is applicable:

> "If the matter were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made. *Moreley Machine Co. v. Lancaster,* 129 U. S. 263, 273-277; *Eibel Co. v. Paper Co.,* 261 U. S. 45, 63; *Winans v. Denmead, supra,* 341."

The claim that all Eden did was position a specific old form of interlock in a new location is contrary to the finding of all three of the Courts below including those who saw the machine and their operation. This is a question of fact in which they are all in accord.

III.

A comparison of the claims in suit, including claim 8 reproduced on page 20 of Petitioners' brief (when the alleged functional parts are emphasized), with the claim in *General Electric v. Wabash* and the claim in *Bassick v. Hollingshead* (298 U. S. 415, 420), shows that the claims of the patent in suit are not functional and that they fall with the claim held valid in the *Bassick-Hollingshead* case and not with the functional claims in *General Electric v. Wabash.*

The following claim 28 is from the *General Electric v. Wabash* case, and is typical of the claims held invalid there as functional (304 U. S. 364, 371):

> "28. A coiled filament composed substantially of tungsten and *capable of use in an electric incandescent lamp without either substantial sagging or offsetting during a normal or commercially useful life.*"

The claim held valid in the *Bassick-Hollingshead* case (298 U. S. 415, 419) is copied below:

> "2. The combination with a hollow coupling member having a pin projecting from one side thereof and a spring-pressed closure, of a pump, a discharge conduit having one end secured to the outlet of said pump, a second hollow coupling member for receiving the closed end of said first named coupling member secured to the other end of said conduit and provided with a bayonet slot adapted to co-act with said pin, a perforated sealing disk mounted to reciprocate in the bore of said coupling member, means *for yieldingly urging said sealing disk against the closed end of said first named coupling member, and means for limiting the movement of said sealing disk in the direction of said second coupling member.*"

In each case we have italicized the functional phrase.

It will be seen that in the Bassick-Hollingshead claim the function is added to the combination of elements, as it is in the claims in suit, and that, therefore, they are not invalid as functional. However, in the claim in the *General*

Electric-Wabash case there is no structure to support the function.

Plainly the claims in suit fall in the class with the Bassick-Hollingshead claim and not in the class of the claim in *General Electric vs. Wabash.*

The only thing admitted to be old was the elements in the combination. There is no admission that the combination was old. A claim is not invalid because the elements in the claim are old, as this Court said in *Expanded Metal v. Bradford,* 214 U. S. 366, 381, as follows:

> "It is perfectly well settled that a new combination of elements, old in themselves, but which produce a new and useful result, entitles the inventor to the protection of a patent. *Loom Company v. Higgins,* 105 U. S. 580-591."

IV.

There is no confusion in the authority on laches. On the other hand, the rule is well and anciently established. The arrival at different results in the different decisions cited is based upon the differences in the facts in the different cases. The finding of the District Court on laches is a Finding of Fact. It is as follows (R. p. 761):

> "8. The plaintiff and its predecessors in title to the Eden patent in suit had no knowledge that the defendants were infringing this patent until after the purchase of this patent by plaintiff. Plaintiff acquired the Eden patent in April, 1934, for the first time notified defendant, The Maytag Company, that it was infringing this patent on June 3, 1934, and on June 16, 1934, asserted this patent against The Maytag Company in a counterclaim in a suit brought by that company for breach of the license contract under which plaintiff had been operating since 1920, and on February 14, 1935, dismissed this counterclaim without prejudice. On December 7, 1936, plaintiff filed this suit. The infringing construction was enclosed within the wringer head so that the mechanism could not be seen without opening the casing and no mention of the

infringing structure or its results was made in the defendants' advertising until after plaintiff filed its suit against defendants on this patent."

A similar finding was made by Judge Thomas in the District Court in Connecticut (21 F. S. 241, 245) as follows:

"It appears from the evidence that plaintiffs acquired the patent on April 18, 1934, but nothing on the record indicates that either plaintiffs or their predecessors in title had knowledge of the defendant's infringement. In *Smith Hardware Company v. Pomeroy Co.*, 299 F. 544, at page 548, Judge Manton, speaking for the Circuit Court of Appeals of the Second Circuit, said: 'It is no defense to a suit for an injunction and accounting for a continuing infringer to say that he has been trespassing upon the rights of the owner of the patent for years with impunity. * * * Laches is not a mere matter of time, but is a question of inequity of enforcing a claim.'

"See, also, *Menendez v. Holt*, 128 U. S. 514, 9 S. Ct. 143, 32 L. Ed. 526; *Drum v. Turner* (C. C. A.) 219 F. 188.

"In any event, plaintiffs have not slept on their rights, because within three months after they acquired title to the patent in suit they brought suit for infringement of the same by filing a counterclaim on June 16, 1934, in the suit of the *Maytag Co. v. Apex Electrical Manufacturing Co.*, in Equity No. 4837, then pending in the United States District Court at Cleveland, Ohio. Moreover, on July 17, 1935, plaintiffs notified the defendant of their ownership of the patent in suit. There is no inequity whatever which prevents plaintiffs from enforcing their claim of infringement here, because there is no evidence whatever that the plaintiffs or their predecessors holding title to the patent in suit had any knowledge of the infringing acts of the defendant prior to the notice to the defendant on July 17, 1935. For these reasons, the defense of laches and estoppel must fail. From the foregoing discussion it follows that the patent to Eden must be held valid and infringed."

The third Conclusion of Law of the District Court in Indianapolis, quoted at the bottom of page 21 of the Petitioner's brief, recites the proper practice of deferring and referring certain questions relating to the extent of the accounting to the Master (*Rubber Company v. Goodyear*, 9 Wall. 788, 800; *Aronson v. Toy*, 1 F. (2) 91, 93 (C. C. A. 3); *Minerals v. Miami*, 264 Fed. 528 (D. C. Del.); *Gordon v. Ford*, 87 F. (2) 390 (C. C. A. 6)). As said at the bottom of page 22 of the Petitioner's brief, the request for review in this Court is not on what the District Court did, but what "it might do, that is, allow the present owner a recovery of damages and profits for the period subsequent to his acquisition of title." This Court, therefore, is asked to review not what has been done, but what Petitioner apprehends might be done.

The conclusions arrived at in the cases from which the excerpts are quoted are not applicable here because the facts are different, as is clear from comparing them with the facts found in the above quoted Finding of Fact 8 of the District Judge.

V.

There is no similarity between this case and the *Schriber-Schroth Case*, as we have already pointed out. There is no justification for the implication that the Second Circuit case was settled to avoid a review by the Second Circuit Court of Appeals. The inference is not only unsupported, but is unwarranted. As we have said, the Respondent made a mistake in settling "for a nominal sum" because the Court of Appeals in the Second Circuit affirmed Judge Thomas on all of the other features which were carried to that Court of Appeals.

There being no diversity of decision anywhere, there being uniformity of decision in two circuits, the patent having expired, no important question being involved, and the sole issue being local to the parties, the Petition for

Writ of Certiorari should, under established practice of this Court, be denied.

Respectfully submitted,

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November 7, 1941.